

INTERFERENCE DIGEST

Interference No. 104,798

Paper No. 10

Name: Ellen M. Dobrusin et al.

Serial No.: 09/623,737

Patent No.

Title: BICYCLIC PYRIMIDINES AND BICYCLIC 3,4-DIHYDROPYPRIMIDINES AS INHIBITORS OF CELLULAR PROLIFERATION

Filed: 09/07/00

Interference with Harris et al.

DECISION ON MOTIONS

Administrative Patent Judge, _____ Dated, _____

FINAL DECISION

Board of Patent Appeals and Interferences, Adverse Dated, 3/31/04

Court, _____ Dated, _____

REMARKS

This should be placed in each application or patent involved in interference in addition to the interference letters.

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

WILLIAM HARRIS,
CHRISTOPHER HUW HILL, and IAN EDWARD DAVID SMITH
(6,150,373),
Junior Party,

v.

ELLEN MYRA DOBRUSIN,
JAMES MARINO HAMBY, JAMES BERNARD KRAMER,
MEL CONRAD SCHROEDER, HOWARD DANIEL HOLLIS SHOWALTER,
PETER TOOGOOD, and SUSANNE A. TRUMPP-KALLMEYER
(09/623,737),
Senior Party.

Interference No. 104,798

Before SCHAFFER, TORCZON, and NAGUMO, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

DECISION ON MOTIONS
(PURSUANT TO 37 CFR § 1.640)

INTRODUCTION

The subject matter of this interference is bicyclic pyrimidines for use as kinase inhibitors for the treatment of various cell proliferation disorders [2001¹ at 1-2; 2008 at 1:1-44²].

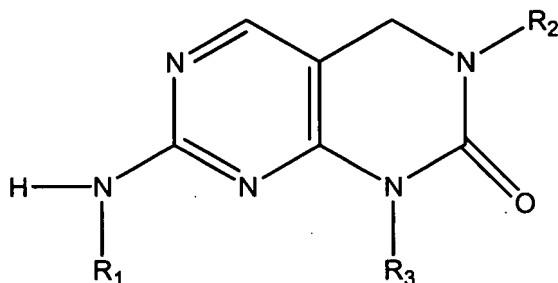
Count 1, the sole count, is (Paper 41³ at 2):

¹ Junior party's exhibits are numbered from 2001; senior party's, from 1001. Exhibit 2001 is Dobrusin's involved 09/623,737 patent application [737 application].

² Wm. Harris, C.H. Hill & I.E. Smith, U.S. Patent 6,150,373 (issued 21 November 2000) [373 patent] (the involved Harris patent). The notation 1:1-44 indicates column 1, lines 1-44.

³ Redeclaration.

A compound having the formula:



where:

R₁ is selected from the group consisting of hydrogen [-H], alkyl having 1-7 carbon atoms and cycloalkyl having 3-7 carbon atoms;

R₂ is selected from the group consisting of alkyl having 1-7 carbon atoms and cycloalkyl having 3-7 carbon atoms; and

R₃ is selected from the group consisting of hydrogen [-H], alkyl having 1-7 carbon atoms and cycloalkyl having 3-7 carbon atoms.

Junior party Harris has filed seven preliminary motions:

- 1 For judgment of unpatentability for lack of written description (Paper 46);
- 2 For judgment of unpatentability for indefiniteness (Paper 47);
- 3 For judgment of unpatentability for improper dependency, indefiniteness, and lack of written description (Paper 48);
- 4 To substitute proposed Harris count 2 [H2] for count 1 and add proposed Harris count 3 [H3], and to add more claims (Paper 49);
- 5 Contingent on the granting of Harris preliminary motion 4, to be accorded benefit of earlier foreign applications (Paper 50);

- 6 Contingent on the denial of Harris preliminary motion 4, to attack the benefit accorded to Dobrusin of its Patent Cooperation Treaty [PCT] application (Paper 51); and
- 7 Contingent on the granting of Dobrusin preliminary motion 1, to be accorded the benefit of earlier foreign applications (Paper 60).

Senior party Dobrusin has filed four preliminary motions:

- 1 To substitute proposed Dobrusin count 2 [D2] for count 1 (Paper 53);
- 2 To be accorded the benefit of an earlier application and an earlier provisional application (Paper 54);
- 3 Contingent on the granting of Dobrusin preliminary motion 1, to be accorded the benefit of an earlier application filed under the Patent Cooperation Treaty [PCT], an earlier application, and an earlier provisional application (Paper 55); and
- 4 Contingent on the granting of Harris preliminary motions 1-3, to amend affected claims or add new claims and, contingent on the granting of Harris preliminary motion 2, to add more claims (Paper 59).

FINDINGS

The following findings are supported by at least a preponderance of the evidence. In each instance, the movant bears the ultimate burden of proof for the relief requested. 37 C.F.R. § 1.637(a); Velander v. Garner, 348 F.3d 1359, 1369-70, 68 USPQ2d 1769, 1777 (Fed. Cir. 2003).

Junior Party Harris

- [1] Harris is a party on the basis of its 6,150,373 [373] patent (Paper 1⁴ at 3), which issued on 21 November 2000 from an application filed 21 October 1999 [2008].

⁴ Notice Declaring Interference.

- [2] Harris was not accorded the benefit of any earlier application (Paper 1 at 3).
- [3] Although the Harris 373 patent has 16 claims, only claim 1 corresponds to count 1 (Paper 41 at 2).
- [4] The Harris real party-in-interest is Hoffmann-LaRoche, Inc. (Paper 4).

Senior Party Dobrusin

- [5] Dobrusin is a party on the basis of its 09/623,737 [737] application (Paper 1 at 4), which was filed 7 September 2000 [2001 at 1].
- [6] Dobrusin was accorded the benefit of its PCT/US99/10187 application (Paper 1 at 4), which was filed 10 May 1999.
- [7] The Dobrusin 737 application has 6 claims that correspond to the count, 54-56 and 58-60, as well as a number of claims that do not correspond to the count (Paper 41 at 2-3).
- [8] Warner-Lambert Co. is Dobrusin's real party-in-interest (Paper 11).

Harris preliminary motion 6: attacking Dobrusin's PCT benefit

- [9] Harris moves (Paper 51) to attack the decision to accord Dobrusin the benefit of its PCT application.
- [10] Dobrusin notes (Paper 75) that its involved application is simply the national stage of the PCT application and urges that on that basis it is either entitled to its PCT date or it is not entitled to any date.
- [11] Harris does not contest that the written description of the involved Dobrusin application and the Dobrusin PCT application are substantively the same.

- [12] Dobrusin argues that it is entitled to the benefit of its PCT application filing date as a matter of law, citing 35 U.S.C. 363, 37 C.F.R. § 1.495, and Ex parte Becher, 2000 WL 33520320 at n.1 (BPAI 2000).⁵

Dobrusin does not specify whether it is relying on the statute or rule as of a particular year. In the absence of a reliance interest, the current law is applied. Singh v. Brake, 222 F.3d 1362, 1371, 55 USPQ2d 1673, 1679 (Fed. Cir. 2000). The current text of 35 U.S.C. 363 is:

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

The statute refers to the "international application designating the United States", which means an application filed under the PCT specifying the United States as a country in which a patent is sought. 35 U.S.C. 351(a), (c) & (e). Under 35 U.S.C. 371, the national stage for the PCT application is "commenced" upon the satisfaction of certain formal requirements, including the payment of a fee and the submission of the inventor's oath. Despite the payment of a new fee and the submission of the oath at commencement of the national stage, the Office treats the international application and the national stage of the international application as a single application. As the Manual of Patent Examining Procedure (§ 1893.03(b)) puts it:

An international application designating the U.S. has two stages (international and national) with the filing date being the same in both

⁵ Although Dobrusin did not note it, the Becher opinion is not binding precedent and, thus, is only as authoritative to the extent it is persuasive. Bd. Pat. App. & Intf., Std. Operating P. 2 at 1 (rev. 4, 29 March 2000) (<http://www.uspto.gov/web/offices/dcom/bpai/sop2rev4.pdf>) [SOP 2].

stages. Often the entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application.

The treaty itself (Article 11(3)) says:

[A]ny international application...accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.

The consequence is that we do not have the power under 37 C.F.R. § 1.633(g) to provide Harris with the relief sought. Rule 633(g) provides:

A motion to attack the benefit accorded an opponent in the notice declaring the interference of the filing date of an earlier filed application.

Since the PCT application is not an earlier application, but rather a stage of the involved application, Rule 633(g) does not apply.

Harris very correctly urges (Paper 82) at that the benefit in question is not benefit in the 35 U.S.C. 119, 120, 121, and 365 sense (i.e., benefit for the purpose of establishing an effective filing date in support of patentability); rather it is than benefit for the purpose of establishing an anticipation (i.e., benefit for denying patentability) under 35 U.S.C. 102(g)(1). Unfortunately, this distinction does not help Harris in this instance. Since the PCT application and the involved case are the same application, there is no question of whether Dobrusin's involved application properly relates back to an earlier application. Congress could, and in one instance did, make an exception for the anticipation context. Section 363 specifically excepts 35 U.S.C. 102(e), which provides:

A person shall be entitled to a patent unless --

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

Plainly Congress could have chosen to exempt § 102(g)(1). The fact that it did not do so strongly supports Dobrusin's contention that it is entitled to its PCT filing date automatically. E.g., Russello v. United States, 464 U.S. 16, 23 (1983) (noting the doctrine that inclusion in one section creates a presumption that omission elsewhere was intentional).

The designation of Dobrusin's PCT application as a "benefit" application was a legal error in the declaration. Harris preliminary motion 6 is DISMISSED as improper under 37 C.F.R. § 1.633(g).

Dobrusin preliminary motion 2: seeking benefit of Dobrusin's provisional applications

- [13] Dobrusin moves (Paper 54) for the benefit of the following provisional applications:

E.M. Dobrusin, J.M. Hamby, J.B. Kramer & M.C. Schroeder, "Bicyclic pyrimidines and bicyclic 3,4-dihydropyrimidines as inhibitors of cellular proliferation", Appl'n No. 60/126,158, filed 25 March 1999 [1006].

E.M. Dobrusin, H.D.H. Showalter & J.B. Kramer, "Bicyclic[4,5-a]pyrimidines and bicyclic 3,4-dihydro[4,5-d]pyrimidines as inhibitors of cellular proliferation", Appl'n No. 60/086,708, filed 26 May 1998 [1005].

- [14] Harris concedes that the examples shown in the 708 provisional application and in the PCT application are the same (Paper 66, admitting fact 2 of Paper 54).

- [15] Harris objects (Paper 66 at 11-12) to the slim basis Dobrusin offers for the relief it seeks.
- [16] The entirety of Dobrusin's argument is (Paper 54 at 6-7, original italics):

Pursuant to Rule 637(f)(3), Dobrusin believes that its benefit applications constitute a constructive reduction to practice of the invention defined in Count 1 of the interference.

With respect to U.S. application 60/126,158, a constructive reduction to practice of the invention of Count 1 is shown (see fact paragraph no[s]. 2-12).

Finally, with respect to U.S. application 60/086,708, a constructive reduction to practice of the invention of Count 1 is shown (see fact paragraph nos. 13-19).

- [17] Harris notes that several of Dobrusin's facts are little more than attorney argument.

A movant has a positive burden of proof to justify the relief it seeks. 37 C.F.R.

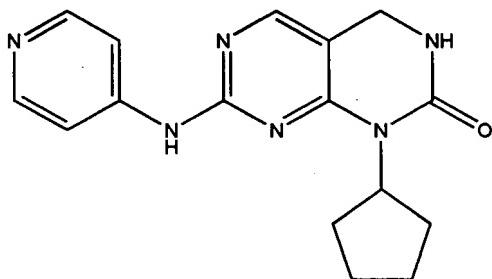
§ 1.637(a). This burden is not satisfied simply by checking off the procedural requirements of 37 C.F.R. § 1.637(f). Hillman v. Shyamala, 55 USPQ2d 1220, 1221 (BPAI 2000). Rather, the burden requires a proof of the substantive elements for the relief sought. Moreover, it is not appropriate to point to the facts and expect the Board to divine and construct the case the movant did not state. Cf. In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) (refusing "to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art"). Such a course of action imposes a burden on the Board and is fundamentally unfair to the opponent, who has no case to oppose until the Board states it for the first time in its decision.

The test for whether a constructive reduction to practice exists is straightforward. A single enabled embodiment within the scope of the count is sufficient for priority benefit since the count is a vehicle for testing priority, not the patentability of the subject matter of the count to either party under 35 U.S.C. 112(1). Hunt v. Treppschuh, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975); Anderson v. Norman, 185 USPQ 371, 372 (Comm'r Pat. 1968) (a single embodiment is good enough for interference benefit, but not for patentability benefit); Mori v. Costain, 214 USPQ 295, 297 (Bd. Int. 1981) ("[I]t is a well settled principle that to constitute a constructive reduction to practice of the invention..[the] application need disclose only one species within the scope of the subject matter in issue."); cf. Transclean Corp. v. Bridgewood Svcs., 290 F.3d 1364, 1370, 62 USPQ2d 1865, 1869 (Fed. Cir. 2002) (stating the general test for anticipation, which requires disclosure and enablement of every limitation, expressly or inherently, in a single reference). Stated another way, Dobrusin must show that its provisional applications anticipate (§ 102(g)(1)) the subject matter of count 1.⁶ Showing obvious variations or equivalents is not sufficient. Eaton v. Evans, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000) (an actual reduction to practice cannot be proven with a showing of an equivalent to a limitation of the count). As in the case of written description under In re Ruschig, 379 F.2d 990, 994-95,

⁶ We acknowledge that the question is often framed in terms of written description under 35 U.S.C. 112(1). Indeed, Harris cites Fields v. Conover, 443 F.2d 1386, 1392, 170 USPQ 276, 280 (CCPA 1971) for this proposition. Subsequently precedent identified the error of confusing written description for a claim under 35 U.S.C. 112(1) with proof of a constructive reduction to practice. Squires v. Corbett, 560 F.2d 424, 433, 194 USPQ 513, 519 (CCPA 1977). In practical terms, there is no difficulty in this case. The principles for which Harris cites In re Ruschig, 379 F.2d 990, 154 USPQ 118 (CCPA 1967) and Lockwood v. American Airlines, 107 F.3d 1565, 41 USPQ2d 1961 (Fed. Cir. 1997), in its opposition are analogously treated in anticipation case law. See Akzo N.V. v. U.S. Int'l Trade Comm'n, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986); Eaton v. Evans, 204 F.3d 1094, 53 USPQ2d 1696 (Fed. Cir. 2000), respectively.

154 USPQ 118, 122 (CCPA 1967), a party is not free to pick and choose among the teachings of a putatively anticipatory reference unless one skilled in the art would have apprehended some basis for making the selections necessary for anticipation. Akzo N.V. v. Int'l Trade Comm'n, 808 F.2d 1471, 1480, 1 USPQ 1241, 1246 (Fed. Cir. 1986), citing In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

- [18] Dobrusin concedes that there is no embodiment in the 158 application that would by itself anticipate, but instead relies on combinations of teachings from the application to teach an embodiment within the scope of count 1 (Paper 54 at fact 4).
- [19] The embodiment Dobrusin points to (Paper 54 at fact 4, citing 1006 at 91, example 9) is 1-cyclopentyl-7-(pyridin-4-ylamino)-3,4-dihydro-pyrimido[4,5-*d*]pyrimidin-2(1*H*)-one:



- [20] Curiously, the parties appear actually to be discussing Example 9 from page 49 of exhibit 1006, in which the R¹ group is 4-methoxyphenyl rather than pyridin-4-yl (above).
- [21] The R¹ in Dobrusin's example 9 on page 91 does not meet the limitation of the count because it is a substituted aryl group, while count 1 only permits hydrogen, a 1-7 carbon alkyl, or a 3-7 carbon cycloalkyl.
- [22] Similarly in example 9 from page 49 R¹ is methoxyphenyl, an aryl group, rather than a hydrogen, a 1-7 carbon alkyl, or a 3-7 carbon cycloalkyl.

- [23] In both case, the R² group also presents a problem because it is hydrogen in both example 9s, whereas the count requires a 1-7 carbon alkyl or a 3-7 carbon cycloalkyl.
- [24] The parties dispute the meaning of the following passage from the 158 application [1006 at 9]:

In yet another preferred group of compounds of Formula I, X is O, W is NH, and R¹ is alkyl, substituted alkyl, phenyl, or substituted phenyl. Preferred R¹ substituted phenyl groups include 4-piperidinyl (with or without substitution), 4-(2-diethylaminoethoxy), 4-pyrrole, 4-pyrazol, and 4-(4-methyl piperazin-1-yl). In an especially preferred group of compounds, X is O, and R¹ is phenyl substituted with hydroxy, alkoxy, NR⁴R⁵, or T(CH₂)_mQR⁴, where R⁴ and R⁵, T, m, and Q are all as defined above. In an even more preferred group of compounds, X is O, and R¹ is phenyl substituted with NR⁴R⁵ or T(CH₂)_mQR⁴, where R⁴ and R⁵, T, m, and Q are all as defined above.

- [25] Harris argues that the preference stated is for compounds that include alkyl substitution for R¹ rather than a preference for an alkyl at R¹ specifically.
- [26] We find that the teaching is broader than Dobrusin contends because several R¹'s in addition to alkyl are "preferred", but that the teaching nevertheless indicates a preference for alkyl at R¹.
- [27] Harris also notes that Formula I is much broader than the example Dobrusin cites in its motion.
- [28] There is some overlap between the paragraph and the examples simply because the contested paragraph also specifies X is O and W is NH, but Harris has a point that Formula I is much broader than either example 9 and includes seven points for substitutions in addition those specified for X and W.
- [29] One skilled in the art would have to pick one of the two example 9s and then modify it on the basis of the paragraph from page 9 with no guidance beyond the fact that the

examples and the preferences on page 9 overlap on two out of nine possible points for substitution.

- [30] Dobrusin urges that such a substitution is "a likely possibility".
- [31] Harris correctly notes that this is attorney argument. No testimony is offered on this point.

Dobrusin has conceded the lack of an express embodiment anticipating count 1. Consequently, Dobrusin must rely on an inherent teaching of such an embodiment. Precedent, however, rejects reliance on "probabilities or possibilities" as a basis for finding an inherent teaching. E.g., MEHL/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999). This is precisely the sort of situation where expert testimony could have breathed life into Dobrusin's argument. Cf. In re Alton, 76 F.3d 1168, 1176, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996) (a written description case that was remanded because for failure to state why an expert declaration did not explain away differences between the disclosed and claimed subject matter). Harris is correct that argument of counsel cannot take the place of evidence lacking in the record. Estee Lauder Inc. v. L'Oreal, S.A., 129 F.3d 588, 595, 44 USPQ2d 1609, 1615 (Fed. Cir. 1997).

- [32] A similar problem arises when Dobrusin relies on pages 3-4 of the specification [1006] to teach that R₂ of the count (Dobrusin's R³) could be a 1-7 carbon alkyl or a 3-7 carbon cycloalkyl (Paper 54 at 6).
- [33] If anything, the problem for Dobrusin's R³ is worse because the same Formula I is involved, the list of possible R³'s is bigger, and there is no statement of preference that

might plausibly tie together the example 9s and the substitution of a 1-7 carbon alkyl or 3-7 carbon cycloalkyl at R³.

- [34] Dobrusin relies on the same arguments for the 708 application with no greater persuasiveness.
- [35] Dobrusin also points (Paper 54, fact 17) to its original claim 7 in the 708 application [1005 at 55] for a teaching within the scope of the count.
- [36] Claim 7 shows a basic structure identical to the basic structure of the count except that the Dobrusin R³ is specified to be hydrogen.
- [37] Claim 7 does not help Dobrusin's case because the hydrogen does not meet the count and, again, there is no additional guidance beyond what has already been discussed on how one would go about picking out substituents for R¹, R², and the missing R³ such that the limitations of the count would be met.
- [38] Dobrusin appears to suggest that, since the 158 application and the involved Dobrusin application share the same examples, Dobrusin should be just as entitled to the benefit of its filing date of its 158 application as it is to its involved application.

The simple answer here is that Dobrusin's entitlement to the filing date of its involved application is not raised by Dobrusin preliminary motion 2. Rather we must determine whether Dobrusin is entitled to the benefit of the filing dates of its 158 and 708 applications, for which Dobrusin has the burden of proof.

- [39] Dobrusin has indicated that its motion may be considered moot (Paper 84 at 1).
- [40] Dobrusin has not withdrawn its motion.

We find that Dobrusin has not met its burden to show that its provisional applications anticipate the subject matter of the count and therefore they do not provide constructive reductions to practice of the subject matter of the count. Consequently, Dobrusin preliminary motion 2 is DENIED.

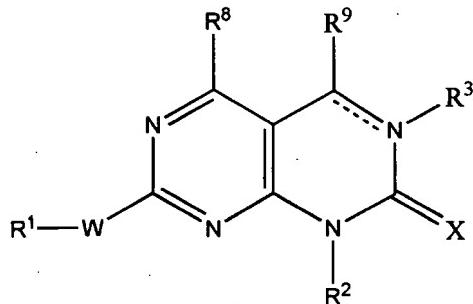
Harris preliminary motion 1: lack of written description

- [41] Harris moves for a finding that all of Dobrusin's involved claims are unpatentable under 35 U.S.C. 112(1) for lack of an adequate written description (Paper 46 at 1).
- [42] All of the claims under attack were added (Paper 38) in response to a stipulated partial judgment (Paper 37) that the previously corresponding Dobrusin claims were unpatentable over prior art.

This case presents the classic challenge of locating blaze marks for a species or, in this case, subgenus in a generic disclosure. Sometimes it is possible. Singh v. Brake, 371 F.3d 1334, 1344, 65 USPQ2d 1641, 1648-49 (Fed. Cir. 2003); In re Driscoll, 562 F.2d 1245, 1249, 195 USPQ 434, 437-38 (CCPA 1977). Sometimes it is not. Fujikawa v. Wattanasin, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996); In re Ruschig, 379 F.2d 990, 994-95, 154 USPQ 118, 122 (CCPA 1967). The difference lies in the presence or absence of blaze marks sufficient to direct one skilled in the art to what is now being claimed.

- [43] Dobrusin has two involved independent claims, claim 54 and claim 58, where claim 54 is drafted as follows:

54. A compound of Formula I



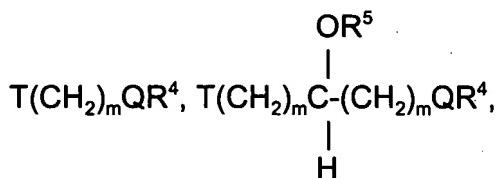
or a pharmaceutically acceptable salt thereof, wherein:

the dotted line represents an optional double bond;

W is NH, S, SO or SO₂;

X is either O, S, or NR¹⁰;

R¹, R², and R¹⁰ are independently selected from the group consisting of H, (CH₂)_nAr, COR⁴, (CH₂)_nheteroaryl, (CH₂)_nheterocyclyl, C₁-C₁₀ alkyl, C₃-C₁₀ cycloalkyl, C₂-C₁₀ alkenyl, and C₂-C₁₀ alkynyl, wherein n is 0, 1, 2, or 3, and the (CH₂)_nAr, (CH₂)_nheteroaryl, alkyl, cycloalkyl, alkenyl, and alkynyl groups are optionally substituted by up to 5 groups selected from NR⁴R⁵, N<sup>+(O)R⁴R⁵, N<sup>+R⁴R⁵Y⁻, alkyl, phenyl, substituted phenyl, (CH₂)_nheteroaryl, hydroxy, alkoxy, phenoxy, thiol, thioalkyl, halo, COR⁴, CO₂R⁴, CONR⁴R⁵, SO₂NR⁴R⁵, SO₃R⁴, PO₃R⁴, aldehyde, nitrile, nitro, heteroaryloxy,



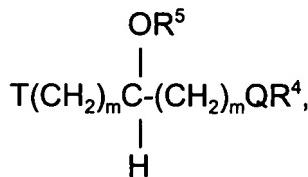
C(O)T(CH₂)_mQR⁴, NHC(O)T(CH₂)_mQR⁴, T(CH₂)_mC(O)NR⁴NR⁵⁷ or T(CH₂)_mCO₂R⁴ wherein each m is independently 1-6, T is O, S, NR⁴, N<sup>+(O)R⁴, N<sup>+R⁴R⁵Y⁻, or CR⁴R⁵, and Q is O, S, NR⁵, N<sup>+(O)R⁵ or N<sup>+R⁵R⁶Y⁻;

⁷ The last N in T(CH₂)_mC(O)NR⁴NR⁵ appears to be an error. Since claim 54 is unpatentable for other reasons, we simply note the problem here.

and additionally alkyl, alkenyl and alkynyl can be further substituted with one to three cycloalkyl groups,

when the dotted line is present, R³ is absent;

otherwise R³ has the meanings of R², wherein R² is as defined above, as well as OH, NR⁴R⁵, COOR⁴, OR⁴, CONR⁴R⁵, SO₂NR⁴R⁵, SO₃R⁴, PO₃R⁴, T(CH₂)_mQR⁴, [sic, or]



wherein T and Q are as defined above;

R⁴ and R⁵ are each independently selected from the group consisting of hydrogen, C₁-C₆ alkyl, substituted alkyl, C₂-C₆ alkenyl, C₂-C₆ alkynyl, N(C₁-C₆ alkyl)₁ or ₂, (CH₂)_nAr, C₃-C₁₀ cycloalkyl, heterocyclyl, and heteroaryl, or R⁴ and R⁵ together with the nitrogen to which they are attached optionally form a ring having 3 to 7 carbon atoms and said ring optionally contains 1, 2, or 3 heteroatoms selected from the group consisting of nitrogen, substituted nitrogen, oxygen, and sulfur;

when R⁴ and R⁵ together with the nitrogen to which they are attached form a ring, the said ring is optionally substituted by 1 to 3 groups selected from OH, OR⁴, NR⁴R⁵, (CH₂)_mOR⁴, (CH₂)_mNR⁴R⁵, T-(CH₂)_mQR₄ [sic], CO-T-(CH₂)_mQR⁴, NH(CO)T(CH₂)_mQR⁴, T-(CH₂)_mCO₂R⁴, or T(CH₂)_mCONR⁴R⁵;

R⁶ is alkyl;

R⁸ and R⁹ independently are H, NR⁴R⁵, N⁺(O)R⁴R⁵, N⁺R⁴R⁵R⁶Y⁻, COR⁴, CO₂R⁴, CONR⁴R⁵, SO₂NR⁴R⁵, SO₃R⁴, PO₃R⁴, CN or nitro;

when the dotted line is absent, R⁹ can additionally be =NOH,

=NOalkyl, =NOalkenyl, =NOalkynyl or =NOCycloalkyl;

and

Y is a halo counter-ion;

with the proviso that: (a) when R⁸ and R⁹ are both hydrogen, W is NH, R¹ is hydrogen and X is NR¹⁰, then R¹⁰ is neither unsubstituted (C₁-C₁₀) alkyl, unsubstituted (C₁-C₁₀) [sic, (C₂-C₁₀)] alkenyl nor unsubstituted (C₁-C₁₀) [sic, (C₂-C₁₀)] alkynyl;

(b) when R⁸ or R⁹ is NR⁴R⁵, N^{+(O)}R⁴R⁵, or N⁺R⁴R⁵R⁶Y⁻, then one or more of R⁴, R⁵ and R⁶ must be, independent of the nitrogen to which said one or more R⁴, R⁵ and R⁶ are attached, heterocyclic or heteroaryl; and

(c) when R⁸ or R⁹ is COR⁴, CO₂R⁴, CONR⁴R⁵, SO₂NR⁴R⁵, SO₃R⁴ or PO₃R⁴, then one or more of R⁴, R⁵ and R⁶ must be, independent of the nitrogen to which said one or more R⁴, R⁵ and R⁶ are attached, (CH₂)_naryl wherein n is zero, 1, 2, or 3, heterocyclic or heteroaryl; [and]

(d) when X is S and W is NH, then at least one of R₁, R₂, R₃, R₈, and R₉ [sic, R¹, R², R³, R⁸, and R⁹] is other than H or C₁-C₃ alkyl.

- [44] Claim 58 is the essentially the same as claim 54 except that claim 58 is directed to a pharmaceutical that includes a excipient (or the like) and the limitations of provisos (b) and (c) in claim 54 are essentially combined into proviso (b) of claim 58 with the addition of (CH₂)_naryl, wherein n is zero, 1, 2, or 3, as an option for R⁴, R⁵, and R⁶ in all cases.
- [45] According to Harris, the provisos cited in claims 54, 55, and 58 are not supported by Dobrusin's application (Paper 46 at 15).
- [46] The provisos in claim 54 are:

(a) when R⁸ and R⁹ are both hydrogen, W is NH, R¹ is hydrogen and X is NR¹⁰, then R¹⁰ is neither unsubstituted (C₁-C₁₀) alkyl, unsubstituted (C₁-C₁₀) alkenyl nor unsubstituted (C₁-C₁₀) alkynyl;

(b) when R⁸ or R⁹ is NR⁴R⁵, N^{+(O)}R⁴R⁵, or N⁺R⁴R⁵R⁶Y⁻, then one or more of R⁴, R⁵ and R⁶ must be, independent of the nitrogen to which said one or more R⁴, R⁵ and R⁶ are attached, heterocyclic or heteroaryl; and

(c) when R⁸ or R⁹ is COR⁴, CO₂R⁴, CONR⁴R⁵, SO₂NR⁴R⁵, SO₃R⁴ or PO₃R⁴, then one or more of R⁴, R⁵ and R⁶ must be, independent of the nitrogen to

which said one or more R⁴, R⁵ and R⁶ are attached, (CH₂)_naryl wherein n is zero, 1, 2, or 3, heterocyclic or heteroaryl; [and]

(d) when X is S and W is NH, then at least one of R1, R2, R3, R8, and R9 [sic] is other than H or C₁-C₃ alkyl.

- [47] Claim 55 is:

A compound of claim 54, wherein W is NH, and R⁸ and R⁹ both are hydrogen.

- [48] The provisos in claim 58 are:

(a) when R⁸ and R⁹ are both hydrogen, W is NH, R¹ is hydrogen and X is NR¹⁰, then R¹⁰ is neither unsubstituted (C₁-C₁₀) alkyl, unsubstituted (C₁-C₁₀) alkenyl nor unsubstituted (C₁-C₁₀) alkynyl;

(b) when R⁸ or R⁹ is NR⁴R⁵, N^{+(O)}R⁴R⁵, N⁺R⁴R⁵R⁶Y, COR⁴, CO₂R⁴, CONR⁴R⁵, SO₂NR⁴R⁵, SO₃R⁴ or PO₃R⁴, then one or more of R⁴, R⁵ and R⁶ must be, independent of the nitrogen to which said one or more R⁴, R⁵ and R⁶ are attached, (CH₂)_naryl wherein n is zero, 1, 2, or 3, heterocyclic or heteroaryl; [sic, and]

(c) when X is S and W is NH, then at least one of R1, R2, R3, R8, and R9 [sic] is other than H or C₁-C₃ alkyl[.]

- [49] Harris argues that (Paper 46 at 16) Dobrusin's specification provides no guidance for the selections or exclusions Dobrusin now claims, distinguishing In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977).

In Johnson, the court reversed a determination of unpatentability for lack of adequate written description. Johnson had lost an interference in which two specifically disclosed species were the subject matter of the count. In further prosecution, Johnson added provisos to his generic claims to exclude the species lost in the interference. When the claims were rejected for lacking support for the exclusions, the court made its disagreement very clear, 558 F.2d at 1019, 194 USPQ at 196:

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of § 112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute.

Johnson poses the question: Does the specification describe the excluded subject matter with sufficient precision that one skilled in the art would have understood the inventor to have identified the excluded subject matter as a distinct invention within the general invention?

- [50] Harris (Paper 46 at 16) answers to the question in the negative because there are no examples in the specification congruent to the provisos, while the provisos are irrelevant for most of the examples said to be within the scope of the claims.
- [51] Naturally Dobrusin, for the most part, disagrees.
- [52] Dobrusin has not presented expert testimony to elucidate what one of ordinary skill in the art would have understood Dobrusin to have possessed.

Proviso (a)

- [53] Proviso (a) is:
 - when R⁸ and R⁹ are both hydrogen, W is NH, R¹ is hydrogen and X is NR¹⁰, then R¹⁰ is neither unsubstituted (C₁-C₁₀) alkyl, unsubstituted (C₁-C₁₀) alkenyl nor unsubstituted (C₁-C₁₀) alkynyl[.]
- [54] Dobrusin (Paper 70 at 5) concedes that its application does not disclose specific examples of compounds meeting all of the requirements of proviso (a), but argues that its:

application discloses several examples in which R⁸ and R⁹ are both hydrogen, W is NH, and X is NR¹⁰, with R¹⁰ being neither unsubstituted

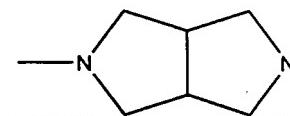
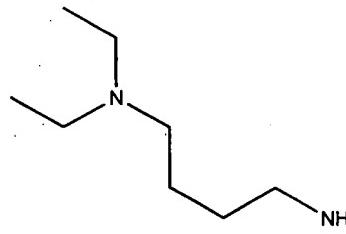
(C₁-C₁₀) alkyl, unsubstituted (C₁-C₁₀) alkenyl nor unsubstituted (C₁-C₁₀) alkynyl. [Citation to two sets of examples discussed below omitted.] It is noted that these specific examples do not contain R¹ as hydrogen but the Dobrusin application also discloses that R¹ can be hydrogen.

- [55] One effect of proviso (a) is that -WR¹ is -NH₂, a primary amine.
- [56] The sets of examples are based on uninvolved claims 11 and 13 (Paper 70 at 5-11), in which each example is a secondary amine.

By definition an uninvolved claim is patentably distinct from the subject matter of the count in the interference. Cf. 37 C.F.R. § 1.606, last sentence (claims to the same patentable invention are designated as corresponding to the count).

- [57] In each example in the cited sets, the R¹ is not remotely close to a hydrogen in size or function.

- [58] In all but three cases, the R¹ includes at least one aromatic group bonded to the nitrogen of the amine. The three exceptions are two instances where R¹ is 4-diethylamino-butylamino (upper right) where the embodiment attaches to the nitrogen on the right and one instance where the amine is converted into part of 5-methyl-hexahydro-pyrrolo[3,4-c]pyrrolo-2-yl (lower right) where the embodiment attaches to the nitrogen on the right.



- [59] Additionally, we note that a similar problem exists for the X limitation. X must be double-bonded to the central bicyclic pyrimidine skeleton. If, as in proviso (a), X is NR¹⁰, then X must be an imine.

- [60] The bicyclic pyrimidine skeleton includes an optional double bond, so the designation of X as double-bonded rather than an optional double bond leaves little room for interpreting X as a secondary amine.
- [61] All of the examples on which Dobrusin relies are secondary amines.
- [62] None of the examples on which Dobrusin relies provide two ($W = NH$ and $X = NR^{10}$) of the four triggers for proviso (a).
- [63] Dobrusin has not pointed to any other guidance for making the selections underlying proviso (a).

In Johnson, the court held that the relevant disclosures specifically identified the subgenera excluded from the scope of an otherwise generic claim.⁸ The disclosures did not expressly state that a genus minus the specifically identified subgenera was a contemplated invention. The court, nevertheless, held that one skilled in the art would have understood from the specific identification of the subgenera that they could be treated as distinct from the rest of the genus. This, the court held, was sufficient to support a finding of written description for a genus minus the subgenera. In reaching this conclusion, the court distinguished In re Welstead, 463 F.2d 1110, 174 USPQ 449 (CCPA 1972). In Welstead, the court agreed with the Office that the applicant lacked support for a subgenus either by virtue of a general description of the subgenus or by virtue of specific examples within the scope of the subgenus. Welstead, 463 F.2d at 1114, 174 USPQ at 451.

⁸ The Board decision on which Dobrusin relies, Ex parte Kosley, 2002 WL 130547, *8 (BPAI 2002) (nonprecedential), is consistent with Johnson, which it cites as authority. In Kosley, as in Johnson, the excluded subject matter was specifically disclosed.

Dobrusin is, in essence, asking us to extend the holding in Johnson to permit the exclusion of subgenera that are no more specifically identified than the subgenus held to lack support in Welstead. We decline to read Johnson so broadly. Johnson permits an inference that items specifically identified as being within a genus may be expressly excluded from the genus without any other indication that the inventor intended the restricted genus to be part of the invention at the time of filing or any other evidence that one skilled in the art would have so understood the disclosure. Johnson finds a clear blaze mark precisely because the excluded matter is specifically identified. Extending Johnson to permit exclusion of subgenera that are neither specifically identified nor otherwise shown to be apparent to those skilled in the art would remove a critical blaze mark without substituting a comparable one.

Dobrusin also argues that the case law permits the removal of one or more members of a Markush group, citing In re Driscoll, 562 F.2d 1245, 1249-50, 195 USPQ 434, 438 (CCPA 1977) and Ex parte Konig, 2001 WL 863718, *4 (BPAI 2001).⁹ The cited cases are readily distinguished from the present facts. In both cases, the species or subgenus was disclosed as a member of a Markush group. Moreover, in winnowing the claims to specific subgenera, the applicants had excluded other specifically disclosed subgenera. Here, there is no comparable basis for excluding the subject matter of the provisos. Moreover, the analogy to Markush selections from a small set of elements is strained past the breaking point in the present case, in which the

⁹ As noted for Ex parte Becher, above, the Konig opinion is not binding precedent and, thus, is only as authoritative to the extent it is persuasive.

independent claims involve very large genera. Finally, the nature of Dobrusin's provisos is far more complex--involving a series of contingent selections--than the simple elimination of discrete, specifically disclosed Markush elements in the cited cases.

A description that merely renders obvious a claimed invention is not sufficient to satisfy the written description requirement for that invention. A description that does not even make the invention obvious will not qualify as a sufficient written description.

Regents of the Univ. of Cal. v. Eli Lilly & Co., 119 F.3d 1559, 1567, 43 USPQ2d 1398, 1405 (Fed. Cir. 1997); Lockwood v. American Airlines, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Dobrusin has not pointed us to evidence that proviso (a) would have been even obvious to a person having ordinary skill in the art. In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994) (discerning no basis for selection of species from large genus); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) (same).

- [64] We do not give much weight to the testimony Harris submitted about the very large number of possible combinations in Dobrusin's claims[2002].

No one disputes that the number of possible subgenera and species is large. Once it is established that the number of species in the genus is at least large, the precise size of the genus is essentially irrelevant. Instead, to select a species or subgenus from a large genus, what matters is the quality of the blaze marks. This is where we have focused and where the focus must remain.

Provisos (b), (c), and (d)

- [65] Proviso (b) is:

when R⁸ or R⁹ is NR⁴R⁵, N^{+(O)}R⁴R⁵, or N⁺R⁴R⁵R⁶Y, then one or more of R⁴, R⁵ and R⁶ must be, independent of the nitrogen to which said one or more R⁴, R⁵ and R⁶ are attached, heterocyclic or heteroaryl[.]

- [66] According to Harris, Dobrusin's specification does not describe R⁸ to be anything other than hydrogen (Paper 46 at fact 16).

- [67] Dobrusin agrees with Harris fact 16 to the extent that its specification offers no explicit support.

- [68] Dobrusin does not elaborate on where the specification provides implicit support for an R⁸ that is anything other than hydrogen.

It is not the responsibility of the Board to identify such support on its own. Cf.

Biotec Biologische Naturverpackungen v. Biocorp., Inc., 249 F.3d 1341, 1353, 58 USPQ2d 1737, 1746 (Fed. Cir. 2001) (noting that it is the job of the nonmovant, not the fact-finder, to provide the evidence necessary to negate the movant's facially adequate position).

- [69] Note that, apart from the provisos, the independent claims provide for R⁸ to be things other than hydrogen and, thus, appear to be generally as defective as proviso (b).

- [70] Provisos (c) and (d) also permit R⁸ to be a substituent other than hydrogen and, thus, suffers the same deficiency as proviso (b).

Oxime ethers

- [71] According to Harris, Dobrusin lacks support for its list of oxime ethers that can be substituted for R⁹ because the specification simply discloses the use of oxime ethers

generically, but provides no examples of any specific oxime ethers (Paper 46 at Facts 32-38).

- [72] Dobrusin does not deny these facts, but notes that the defect would be cured in proposed additional claims (Paper 70 at 24).

It is entirely possible to go overboard with an argument like the one Harris is making.

- [73] The simplest case for an oxime ether ($=N-O-R^x$) would be an alkyl oxime ether ($=NOalkyl$) like $=NOmethyl$. Presumably one skilled in the art would know as much and quite possibly would understand the simplest case to be a default choice.

- [74] The problem comes from the remaining selections ($=NOalkenyl$; $=NOalkynyl$; and $=NOcycloalkyl$), which provide additional, more complex examples of oxime ethers, but excludes as Harris observes many, many other possible oxime ethers such as $=NOphenyl$ or $=NOaryl$.

- [75] This is the sort of problem for which expert testimony would have been helpful in establishing what a generic recitation of oxime ether would have meant to one skilled in the art.

- [76] On the face of Dobrusin's specification, there does not appear to be support for the limited selection of oxime ethers that Dobrusin claims as substituents for R^9 .

The R^1 and R^2 substituents in Dobrusin claims 56, 59, and 60

- [77] Harris argues that there is no basis for selecting six substitutes for R^1 and R^2 out of the original list of nine.

This argument shows the limits of Harris's combinatorial arguments. Both the retained and the eliminated choices are explicitly listed. The elimination of some but not all of the choices is the sort of winnowing that Johnson permits.

The Hoffman-LaRoche patents

- [78] Dobrusin cites patents issued to the Harris real party-in-interest as examples where moieties have been permitted to be removed to secure allowance.

The simplest answer to this argument is that the courts have recognized written-description cases to be highly fact-specific. E.g., Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989, 1001, 54 USPQ2d 1227, 1235 (Fed. Cir. 2000); Driscoll, 562 F.2d at 1249, 195 USPQ at 438. Without a fuller analysis of the facts underlying the Hoffman-LaRoche patents, it would be impossible to say what their relevance to the present case might be. Moreover, as the Court of Customs and Patent Appeals dryly noted in a design case, "we are not saying the issuance of one patent is a precedent of much moment." In re Zahn, 617 F.2d 261, 267, 204 USPQ 988, 995 (CCPA 1980).¹⁰ Fortunately, we need not (and emphatically do not) decide this question with regard to the Hoffman-LaRoche patents. We need only look to the intrinsic evidence, Dobrusin's specification and the contested claims, and the extrinsic expert testimony to the extent it is consistent with the intrinsic evidence. These leave us with the firm conviction that

¹⁰ Moreover, assuming arguendo that, as Dobrusin seems to suggest, the Hoffman-LaRoche claims are invalid if Dobrusin's claims are not patentable, the Zahn dictum is consistent with the maternal dictum that two wrongs do not make a right. Congress recognizing the possibility of invalid patent claims has provided no fewer than five general mechanisms for addressing the possibility: corrections, reissue applications, two reexamination procedures, and invalidity defenses, the last of which has always been a feature of the United States patent system. Consequently, the Hoffman-LaRoche patents have little or no bearing on the question of whether Dobrusin's claims are patentable on the unique facts of this proceeding.

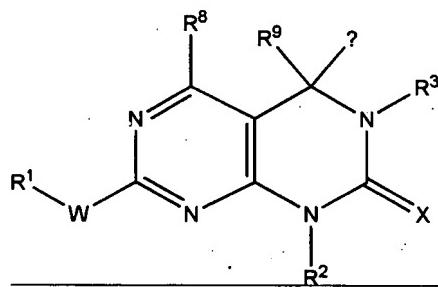
Dobrusin's contested claims are, more likely than not, unpatentable for lack of sufficient written description in keeping with § 112(1).

Except as discussed above, the additional limitations of the dependent claims were not argued to cure the defects of the parent claims and hence the dependent claims stand or fall with their respective parent claims. In re Van Geuns, 988 F.2d 1181, 1186, 26 USPQ2d 1057, 1060 (Fed. Cir. 1993).

In view of our finding that Dobrusin's contested claims lack sufficient written description, we GRANT Harris preliminary motion 1 for judgment of unpatentability against Dobrusin claims 54-56 and 58-60.

Harris preliminary motion 2: indefiniteness

- [79] According to Harris, Dobrusin claims 54, 55, and 58 are indefinite because they permit the following undefined moiety ["?"] whenever R⁹ is a single-bonded substituent (Paper 47 at 1):



The test for indefiniteness is whether (or not) one skilled in the art would understand the bounds of the claim when read in light of the specification. Miles Labs. Inc. v. Shandon Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993).

- [80] Harris provides the expert testimony of Dr. Harry G. Brittain, who testifies that carbon atoms need four bonds, but that Dobrusin's specification does not offer any guidance on what substituent is connected to the ring carbon connected to R⁹ to provide a fourth bond [2003].
- [81] Dr. Brittain does not testify directly to the question of how one skilled in the art would understand an undesignated substituent on a ring carbon in organic chemistry.
- [82] We find Dr. Brittain's testimony to be credible insofar as it goes, but incomplete in its failure to address the central fact at issue: what one of skill would have understood.
- [83] Dobrusin provides a wealth of textbook evidence documenting the convention in organic chemistry of omitting hydrogens bonded to ring carbons as a way of simplifying drawings [1011; 1012; 1013].
- [84] The textbook evidence is, in this instance, especially credible because it corresponds to this panel's understanding of the convention.
- [85] We find it extremely likely that one skilled in the art would assume the "missing" substituent was hydrogen without giving the matter a second thought.
- [86] Dobrusin also points to numerous examples of this convention from Hoffman-LaRoche patents and Harris experts' publications.
- [87] The evidence of the Hoffman-LaRoche patents and Harris publications is simply cumulative to the evidence provided by the textbooks.

In construing claims, we must accord the claim the broadest construction that is reasonable in view of the specification as interpreted by one skilled in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). We conclude that

the only reasonable construction of the contested Dobrusin claims from the perspective of one skilled in the art would include an assumption that the "missing" substituent is a hydrogen. Consequently, we DENY Harris preliminary motion 2 for judgment of unpatentability against Dobrusin claims 54, 55, and 58.

Harris preliminary motion 3: defects in the R¹/R² substituents for Dobrusin claim 56

- [88] Harris moves for judgment that Dobrusin claim 56 and its dependent claims 59 and 60 are unpatentable under 35 U.S.C. 112(1) (written description) and under 35 U.S.C. 112(2) and (4) (indefiniteness/improper dependency) (Paper 48 at 1).
- [89] Dobrusin admits all of the material facts in Harris preliminary motion 3 (Paper 72 at 1).
- [90] Dobrusin claim 56 depends (through claim 55) from claim 54 (Paper 48, Fact 10).
- [91] Claim 56 includes optionally substituted (CH₂)_nheterocyclyl as an R¹/R² substituent, but its parent claim 54 does not (Paper 48, Fact 11).
- [92] Claim 56 is not an original claim (Paper 48, Fact 12).
- [93] Dobrusin's disclosure does not support the use of a substituted (CH₂)_nheterocyclyl as an R¹/R² substituent (Paper 48, Fact 13).
- [94] Dobrusin's only response is that its proposed amendments would moot the issue (Paper 72 at 2).

Claim 56 is an improper dependent claim because it includes a subgenus (optionally substituted (CH₂)_nheterocyclyl R¹/R² substituents) that is not included within the scope of the parent claim. In this regard, we perceive no difference between Harris's argument under §112(2) or §112(4).

The case law on improper dependency as a basis for unpatentability is extremely sparse, presumably because applicants almost always correct manifest dependency problems without contesting the rejection. E.g., Mycogen Plant Sci., Inc. v. Monsanto Co., 261 F.3d 1345, 1348, 59 USPQ2d 1852, 1854 (Fed. Cir. 2001) (on petition for rehearing) (noting a rejection under §112(4) for improper dependency during prosecution mooted by amendment). The cases cited for improper dependency in Harris's motion, and the cases they in turn cite, are non-binding Board decisions.

SOP 2. They break into two classes: (1) improper dependency that creates a conflict between the parent and the dependent claims about their respective scopes, Ex parte Albery, 1998 WL 1736203 (BPAI 11 May 1999), and Ex parte Siemers, 1998 WL 1736201 (BPAI 10 May 1999); and (2) improper dependency that creates a fee-payment problem, Ex parte Porter, 25 USPQ2d 1144 (BPAI 1992), and Ex parte Moelands, 3 USPQ2d 1474 (BPAI 1987). The situation of Porter and Moelands is not before us. The present case is analogous to the problem in Albery and Siemers, although it is not clear why this class of § 112(4) rejection is not simply a species of § 112(2) indefiniteness rejection. It further follows that a rejection of both the parent and the dependent claim is appropriate because a rejection of one, but not both, implicitly assumes which of the claims is "right". Cf. Mycogen Plant Science, 261 F.3d at 1348, 59 USPQ2d at 1854, in which both the parent and the dependent claim were rejected. In the present case, we need not address the indefiniteness of the parent claim, claim 54, because it has already been held to be unpatentable as a consequence of Harris preliminary motion 1.

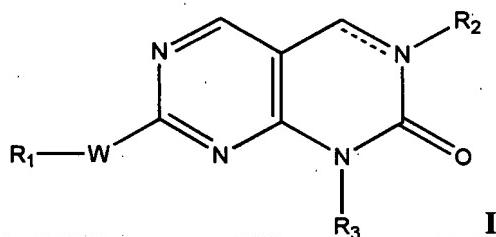
Harris has carried his burden to show that Dobrusin claim 56 lacks sufficient written description under §112(1) and improperly depends within the meaning of §§112(2)/112(4). Dependent claims 59 and 60 share the defects of claim 56. Accordingly, we GRANT Harris preliminary motion 3 for judgment that Dobrusin claims 56, 59, and 60 are unpatentable.

Dobrusin preliminary motion 1: substituting a new count and amending claims

Substituting Dobrusin count 2 [D2] for count 1

- [95] Dobrusin moves to substitute count D2 for count 1 (Paper 53 at 1).
[96] Count D2 would be:

A compound having the formula:



wherein

W is N, S, SO or SO₂,

R₁ is selected from the group consisting of hydrogen, alkyl having 1 to 7 carbon atoms, aryl and cycloalkyl having 3-7 carbon atoms,

when the dotted line is present, R₂ is absent; otherwise

R₂ is selected from the group consisting of hydrogen, alkyl having 1 to 7 carbon atoms, aryl and cycloalkyl having 3-7 carbon atoms,

R₃ is selected from the group consisting of hydrogen, alkyl having 1 to 7 carbon atoms, aryl, heteroaryl and cycloalkyl having 3-7 carbon atoms

wherein said aryl is a phenyl or naphthyl group which is unsubstituted or optionally mono- or multiply-substituted by halogen, lower alkyl, lower alkoxy, lower-alkoxy lower alkyl, trifluoromethyl, hydroxy, hydroxy lower-alkyl, carboxylic acid, carboxylic ester, nitro, amino, or phenyl, wherein the substituents may be the same or different, and/or by a group of the formula--Z--NR⁴R⁵ or --Z--OR⁶ in which Z represents a spacer group (CH₂)_n and n = 0, 1, 2, 3 or 4 and R⁴ and R⁵ each individually represent hydrogen or lower alkyl or R⁴ and R⁵ together with the nitrogen atom to which they are attached represent a 4-, 5-, or 6-membered saturated or partially saturated or 5- or 6-membered aromatic heterocyclic group which contains one or more hetero atoms selected from nitrogen, sulfur and oxygen and which is optionally substituted by lower alkyl, lower alkoxy and/or oxo and/or which is optionally benz-fused, and in which R⁶ is defined as H or lower alkyl,

and said hetero aryl is a 5- or 6-membered heteroaromatic group which contains one or more hetero atoms selected from N, S, and O and which may be benz-fused and/or substituted in the same manner as said aryl defined above.

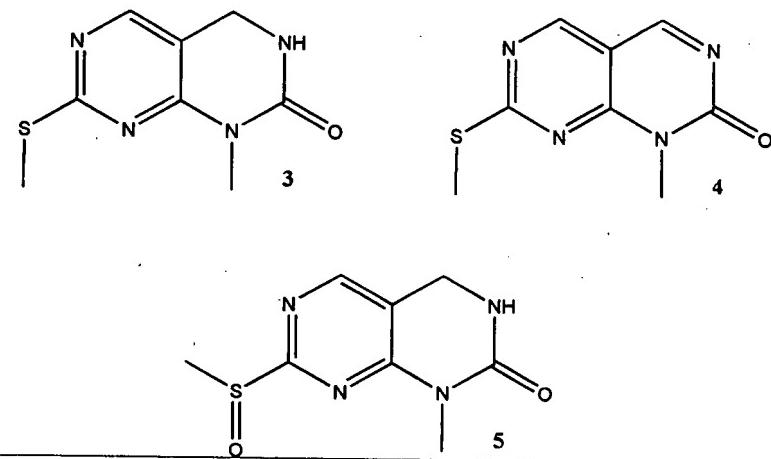
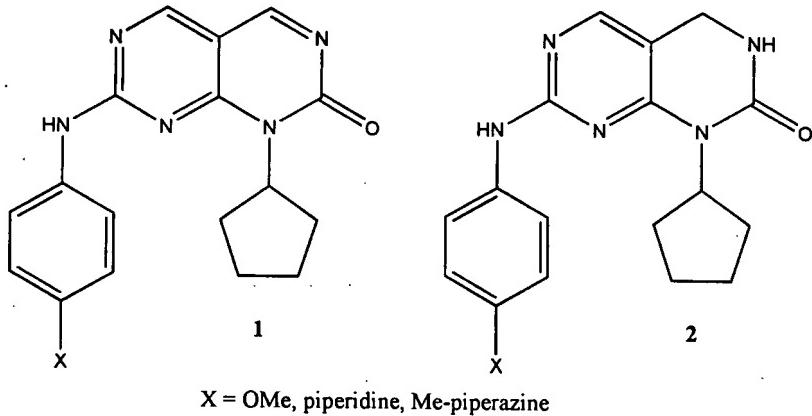
It is vital to keep in mind that positions of R² and R³ for Dobrusin's claims are the reverse of what they are for Harris claims, count 1, and all of the proposed counts.

- [97] One difference over count 1 is that the -NHR₁ of count 1 has been replaced with -WR₁ in count D2, where W could be N, S, SO, or SO₂.
- [98] W is not indicated to be -NH- as in count 1.
- [99] It is not clear what -NR₁ would mean in proposed count D2.
- [100] Dobrusin has not documented a convention for omitting hydrogens from nitrogen in organic chemistry figures.
- [101] A second difference is that count D2 adds aryl to the list of potential substituents for R₁.
- [102] A third difference, is that D2 permits an optional double bond (dotted line) in lieu of an R₂ substituent.

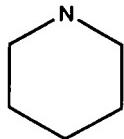
- [103] If R_2 is present (rather than the double bond), then count D2 adds hydrogen and aryl as potential substituents for R_2 .
- [104] R_3 adds aryl and heteroaryl to the choices in count 1.
- [105] Moreover, "aryl" (presumably for all three Rs, all of which can now be aryl) and heteroaryl are defined with great specificity.

A preliminary motion to broaden the count on the basis that a party's best or earliest proofs lie outside the scope of the count should (1) proffer the party's best proofs, (2) show that such proofs indeed lie outside the scope of the current count, and (3) show the new count is not excessively broader than necessary to encompass the proffered proofs. Louis v. Okada, 59 USPQ2d 1073, 1076 (BPAI 2001).

- [106] Dobrusin proffers the following five best proofs [1001 at 2]:

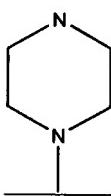


[107] Piperidine is:



where the rest of either proof 1 or proof 2 is bonded to the nitrogen.

[108] Methyl-piperazine is:



where the rest of either proof 1 or proof 2 is bonded to the top nitrogen.

- [109] The proposed definitions of W and the R groups are broadened more than is necessary to encompass the five proffered proofs. For example, there is no basis for W to be SO₂ either in count 1 or in the examples proffered as a justification to broaden the count. Similarly, the count D2 list for the R groups permits many choices, while the proffered proofs exemplify six (hydrogen, methyl, cyclopentyl, 4-methoxy-phenyl, 4-piperidin-1-yl-phenyl, and 4-(4-methyl-piperazin-1-yl)-phenyl) additional possibilities, and not all of those are applicable to all of the R groups. For instance, only hydrogen is exemplified for R₂.
- [110] Dobrusin provides no justification for the proposed scope beyond count 1 and the five proffered proofs.

Harris correctly notes that satisfaction of the procedural requirements of 37 C.F.R. § 1.637(c) is not, in itself, sufficient to justify the granting of a motion under 37 C.F.R. § 1.633(c). Cf. Hillman v. Shyamala, 55 USPQ2d 1220, 1222 (BPAI 2000) (denying a motion under § 1.633(f) for failure to make out a case on the merits). A count must be directed to subject matter that is the same invention, i.e., patentably indistinct. As movant, Dobrusin bears the responsibility of showing that the added elements either (1) are directed to the same invention as the present count or (2) are directed to subject matter that the parties are commonly claiming.

Proofs of priority must be within the scope of the count--obvious equivalents do not count. Eaton v. Evans, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000). Consequently, a party may need a broader count to ensure its patentably

indistinct proofs to the same invention are admissible. In such a case, however, there must be a showing that the proofs are, in fact, patentably indistinct from the subject matter of the current count. Alternatively, a count may be broadened simply because both parties are claiming broader common subject matter, but in such a case there must be a showing that the broader claims in fact define the same invention. Under either theory, Dobrusin has failed to make an adequate showing.

- [111] Dobrusin's argument for patentable indistinctness is based in part on the uncontested fact that various claims that correspond to count 1 were not restricted from claims that do not correspond (e.g., Paper 53 at 16 and 20).

There are several important fallacies in this argument. First, the Board is not bound by patentability determinations of an examiner during ex parte prosecution. 35 U.S.C. 135(a) (empowering the Board to determine patentability during an interference); Wellcome, Inc. v. Cabilly, 56 USPQ2d 1983, 1984 (BPAI 2000); accord Licausi v. OPM, 350 F.3d 1359, 1364 (Fed. Cir. 2003) (statutory decision maker is not bound by earlier agency determination). Second, the decision to restrict is discretionary and accompanied by consequences that can effect patent term, 35 U.S.C. 121(1) and (4), which renders patentable distinctness neither a necessary nor a compulsory basis for a restriction requirement. See In re Weber, 580 F.2d 455, 458, 198 USPQ 328, 332 (CCPA 1978) (noting the practical administrative considerations underlying restriction practice). Finally, if a failure to restrict is sufficient to show patentable indistinctness then a rejection of any unrestricted claim in an application would be sufficient to reject all unrestricted claims. This has never been the law.

- [112] Dobrusin's arguments also rely on the patentability of Dobrusin claim 54 (Paper 53 at 22), a claim that has been held to be unpatentable (*supra*).

[113] Harris has criticized Dobrusin's use of phrases like "fall within", "comparable", "embrace", and "close to covering".

Such characterizations are unhelpful in a patentability analysis under 35 U.S.C. 102 and 103. If there is a difference, that difference must be identified and explained in terms of its obviousness. *Cf. Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966) (identifying differences is an element in an obviousness analysis). By themselves, these characterizations are no more than unsupported attorney argument.

The problem with Dobrusin's approach to broadening the count to include more subject matter claimed by both parties is that rather than explaining why differences between the claims of the parties constitute the same invention, Dobrusin masks such difficulties by listing such differences as alternatives within the count. Dobrusin, as movant, has failed to justify substituting the broader count that it has proposed. Consequently, Dobrusin preliminary motion 1 is DENIED with regard to substituting count D2. The portions of the motion seeking the designation of additional claims to count D2 is moot. Since Dobrusin claims 13 and 14 do not correspond to a count, the amendment requested for those claims lies outside of our jurisdiction under 37 C.F.R. § 1.633(c), which is limited in scope to the amendment of claims corresponding to a count.

- [114] Both parties moved (Harris preliminary motion 7 and Dobrusin preliminary motion 3) for benefit with respect to count D2.

Since count D2 is not adopted, both motions for benefit with respect to count D2 are DISMISSED as moot.

Dobrusin preliminary motion 4: amending and adding claims

[115] Dobrusin moves to amend and add claims (Paper 59 at 1). Specifically, Dobrusin wishes to amend both independent claims (54 and 58) as well as dependent claim 56. Contingent on judgment of unpatentability for claims 54, 55, and 58, Dobrusin wishes to add claims 61-76. Finally, contingent on judgment of unpatentability for claims 54, 55, and 58 and on a decision to substitute Dobrusin's proposed count 2 for current count 1, Dobrusin wishes to add claims 77-80.

Amending claims 54, 56, and 58

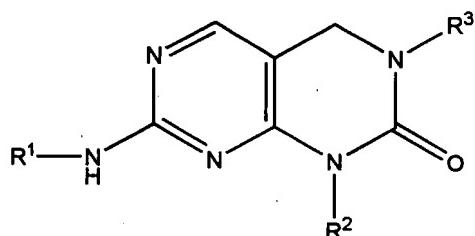
- [116] Dobrusin proposes to amend claims 54, 56, and 58 to correct typographical errors.
- [117] Claims 54, 55, and 58 have been held to be unpatentable (supra).
- [118] Claim 56 depends from claim 55, which in turn depends from claim 54.
- [119] The motion was filed under 37 C.F.R. § 1.633(i) (Paper 59).

Motions filed under 37 C.F.R. §§ 1.633(i) and 1.633(j) are responsive motions that permit a party to address an attack on patentability among other things. In the present case, Dobrusin claims 54, 55, and 58 have been held to be unpatentable for lack of an adequate written description pursuant to 35 U.S.C. 112(1). Consequently, a responsive motion is appropriate, but is moot if it does not correct the cause of the unpatentability.

- [120] According to Dobrusin, the amendments to claims 54, 56, and 58 correct only obvious clerical errors.

- [121] The amendments are shown in Appendix 2 of Paper 59.
- [122] We agree with Dobrusin's representation that the amendments to independent claims 54 and 58 are clerical in nature.
- [123] For neither independent claim do the amendments cure the defects that led to the holding of their unpatentability above.
- [124] Dobrusin claim 56 is amended to eliminate all additional limitations beyond the basic structure shown:

56. A compound of Claim 55 having the formula[:]



- [125] The structure expressly includes the limitations of claim 55.
- [126] A compound of claim 56 meets the trigger of proviso (a) in grandparent claim 54 (because R^8 and R^9 , which bond to the top two ring carbons, are both hydrogen and the W of WR^1 is $-NH-$).
- [127] Proviso (a) was held to be unsupported above.

Since the proposed amendments to claims 54, 56, and 58 do not appear to cure the written-description defects of the claim as held above, the proposed amendments are moot.

Adding claims 61-76

[128] Dobrusin moves to have claims 61-76 added to the interference to correspond to count 1, contingent on a determination of unpatentability for Dobrusin claims 54, 55, and 58.

[129] Claims 54, 55, and 58 have been held to be unpatentable (*supra*).

Since the motion is intended to be responsive to this finding of unpatentability, it is necessary to determine whether the proposed claims avoid the problems of the claims held to be unpatentable. A movant seeking to add claims must "show the patentability to the applicant" of the added claims. 37 C.F.R. § 1.637(c)(2)(iii). The potentially open-ended nature of such a requirement has led to its being interpreted to mean that only a showing of written description was necessary unless additional circumstances required more of a showing. Chief Administrative Patent Judge, "Interference Practice - Interference Rules Which Require a Party to 'Show the Patentability' of a Claim", 1217 Offl Gaz. 17 (PTO 1998). Harris complains, with some justification, that Dobrusin has not complied with the requirements of § 1.637(c)(2)(iii) (Paper 67 at 13-14).

[130] A similar problem occurred when Dobrusin first submitted the Dobrusin claims presently involved in the interference and Dobrusin was required to make an additional showing of written-description support before the claims were accepted (Paper 38).

Dobrusin had actual notice of the expectation for a rigorous showing of written description for new claims. While claim charts are a vital adjunct to a motion involving new claims, they are not a substitute for an explanation of the support for the new

claims or of how the claims avoid prior art cited against previous Dobrusin claims during the interference when the prior art is close.¹¹ Harris is right to complain because Dobrusin's approach has essentially shifted the burden from the movant, Dobrusin, to Harris and the Board to thread their way through the record to see what support Dobrusin might be using before any analysis can even begin. This approach is inherently unfair to Harris, imposes inefficiencies on the Board, and falls short of the obligations of a movant.

- [131] Dobrusin's entire argument for claims 61-76 with respect to § 1.637(c)(2)(iii) is (Paper 59 at 4):

[Dobrusin's] proposed claims 61-76 are narrower in scope than independent claims 54 and 58 and they are patentable for at least the same reasons claims 54 and 58 are patentable.

- [132] Harris notes that in the context of written description, "narrower" claims are not necessarily thereby patentable (Paper 67 at 15).

As noted previously, the case law requires each written description contest to be approached on its own facts, but as a general rule, the case law does not suggest that a broad description automatically supports a narrower claim. E.g., Fujikawa, 93 F.3d at 1571, 39 USPQ2d at 1905; Ruschig, 379 F.2d at 994-95, 154 USPQ at 122; In re Smith, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) (footnote omitted):

We see nothing inherently wrong with a particular principle of patentability which under certain circumstances operates to defeat the patentability of

¹¹ The claim charts themselves leave much to be desired because they point for support to other claims (in a few cases original claims, but mainly claims that have been held to lack support) for support rather than relying on the Dobrusin specification as required under § 112(1). The failure to cite to the specification largely frustrates the purpose of the claim chart. The only three instances where the specification is cited directly (claims 54, 78, and 80) are not the subject of this portion of the decision.

a narrow, but not a broader, claim, and, ordinarily, the mere fact that under such a principle a broader claim would pass muster is not a basis for adjusting the principle to render the narrower claim patentable.

- [133] In any case, dependent claims 54 and 58 were held to lack sufficient written description as required under § 112(1) with regard to the following limitations: provisos (a)-(d) and the limited number of oxime ethers.
- [134] These limitations are present (or absent) in proposed claims 61-76 as follows:

Claim	Proviso (a)	Proviso (b)	Proviso (c)	Proviso (d)	Oxime ether
61	✓	✓	✓	-	-
62	✓	-	-	-	-
63	-	-	-	-	-
64	-	-	-	-	-
65	✓	✓	✓	✓	-
66	✓	-	-	-	-
67	-	-	-	-	-
68	-	-	-	-	-
69	✓	✓	✓	¹²	-
70	✓	-	-	-	-
71	-	-	-	-	-
72	-	-	-	-	-
73	✓	✓	✓	-	-
74	✓	-	-	-	-
75	-	-	-	-	-
76	-	-	-	-	-

¹² Recall that in claim 58, on which claim 69 is based, provisos (b) and (c) of claim 54 were essentially combined into proviso (b), with proviso (d) thus becoming proviso (c).

- [135] As the chart above indicates, proposed claims 61, 63, 65, 66, 69, 70, 73, and 74 do not cure the written description problems previously discussed.

Since these claims are not even superficially responsive to all of the advanced grounds of unpatentability, they plainly do not meet the requirements of § 1.637(c)(2)(iii).

- [136] Claims 63, 64, 67, 68, 71, 72, 75, and 76 superficially appear to address the written description problems of the provisos by eliminating the provisos, and the problem of the oxime ethers by substituting an oxime.
- [137] Moreover, as Harris notes (Paper 67 at 16), even these claims are not narrower in all respects because, among other things, they eliminate provisos that constrained the scopes of the claims in certain contingencies.
- [138] In particular, proviso (d)¹³ constrained at least one of R¹, R², R³, R⁸, and R⁹ to be other than hydrogen or a 1-3 carbon alkyl whenever X is sulfur and W is -NH-.
- [139] Claims 63, 64, 67, 68, 71, 72, 75, and 76 permit X to be sulfur and W to be -NH-, but eliminate the proviso that would constrain the choice of substituents for R¹, R², R³, R⁸, and R⁹, to wit, at least one of the R substituents listed had to be something other than hydrogen or a 1-3 carbon alkyl.
- [140] Harris argues that under the joint stipulation permitting Dobrusin to amend its claims before the preliminary motions period began in earnest, any broadening amendment would not be permitted.

¹³ Proviso (c) for claims derived from claim 58.

- [141] Dobrusin responds that it agrees that it cannot broaden its claims, but argues that it has narrowed its claims in every respect (Paper 85 at 6).

If the claims 63, 64, 67, 68, 71, 72, 75, and 76 are, in fact, no longer as limited as the provisos require, then they would be broader in at least some respect. On the other hand, if the claims include the provisos in another guise, they may still be unpatentable.

- [142] Claim 63 permits X to be sulfur and W to be -NH-, but limits R¹ to exclude hydrogen and alkyl.

- [143] R⁸, however, may be substituents other than hydrogen in claim 63.

- [144] Proviso (d) was considered not to be supported above because of the lack of support for embodiments featuring X=S, W=NH, and R⁸=something other than hydrogen.

There may be an explanation for why this is not a problem, but if so it is not apparent in Dobrusin's motion. A movant may not conscript the opponent and the Board into becoming its attorney and making out its case in the first instance.

- [145] Claim 67, which depends from claim 63, cures this defect by requiring both R⁸ and R⁹ to be hydrogen.

- [146] Claim 64 and its dependent claim 68 do not constrain R¹, R², R³, R⁸, and R⁹ from all being hydrogen when X=S and W=NH.

This fact means that, at least in this regard these claims are broader than the claims permitted under the joint motion.

- [147] The joint motion of the parties provided, in part, that (Paper 37 at 13-14, bracketed material in the original):

10. Dobrusin shall be free to file a motion under Rule 633(i) [second round] in response to any Harris Rule 633(a) motion. Should Dobrusin file any such Rule 633(i) motion, no amendment may be made which would result in any claim covering any subject matter falling outside the scope of new claim(s) 54-59 as they appear above;

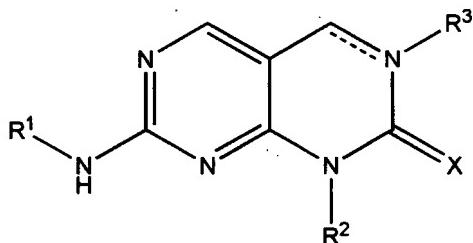
11. Harris and Dobrusin shall be free to file Motions under Rule 633(c) to refine the interfering subject matter, including such motions which seek to substitute and/or add a count. However, Dobrusin shall not file any Rule 633(c) motion seeking to amend any claim or to add any additional claim that covers any subject matter that falls outside the scope of claims 54-59 as they appear above. Harris shall not file any Preliminary Motion under Rule 633(a) seeking entry of judgment that any such amended or additional claim presented by Dobrusin in a Rule 633(c) motion is unpatentable in view of any prior art, including but not limited to the prior art listed in paragraph 1.

- [148] The joint motion was provisionally granted in Paper 38 and, after the filing of Dobrusin's claim chart and clean copy of the new claims (Papers 39 and 40), was implemented by redeclaration (Paper 41).
- [149] Dobrusin received the benefit of the joint motion: a chance to amend its claims unopposed and immunity from a Harris motion for judgment against Dobrusin on the basis of prior art.

Again, there may be a reason why these claims are in fact not broader, but on their face they are. It should not be up to Harris and the Board to first determine what Dobrusin might have argued and then determine whether the possible argument is correct.

The analysis for claims 71, 72, 75, and 76 parallels the analysis for 63, 64, 67, and 68, respectively, except that the proviso in question is proviso (c) rather than proviso (d). Consequently, claims 63 and 71 appear to lack support, while claims 64, 68, 72, and 76 impermissibly broaden the scope of the claims.

- [150] Remaining proposed claims 67 and 75 have the following basic structure:



- [151] In each case, Dobrusin cites as support for claims 67 and 75 "original claim 2 and claim 55" (Paper 59, App. 2 at 33 and 54).
- [152] Dobrusin offers no other argument for the support of claims 67 and 75 specifically beyond that provided in Appendix 2.
- [153] Claim 55 is not said to be an original claim and does not appear to be original in the PCT application [1007].

We note that the mere fact that a claim is an original claim is no guarantee of written description. Enzo Biochem, Inc. v. Gen-Probe, Inc., 296 F.3d 1316, 1329, 63 USPQ2d 1609, 1616 (Fed. Cir. 2002). The Enzo Biochem decision was concerned with a case in which neither the original claim nor the specification provided an adequate description of a claimed structure or material, for instance, where the description was of a function without a clear showing of necessarily corresponding structure. In the present case, the claims describe chemical genera with structural rather than functional limitations, so the concern of Enzo Biochem does not appear to apply to these facts.

- [154] Claim 2 appears to be an original claim in the PCT application [1007 at 108].

- [155] Claim 2 depends from claim 1, but specifies N, H, and NH at positions that yield the same basic structure as claims 67 and 75, as shown above.
- [156] Claims 67 and 75 depend from claims 63 and 71, respectively, in the same relationship as claim 2 depends from claim 1 except that claim 2 specifies the substitution of two nitrogens that are already present in claims 63 and 71.
- [157] Dobrusin has already conceded the unpatentability of claims 1 and 2 in view of prior art (Paper 37 at 4).¹⁴

The burden to "show patentability" includes not only a requirement to show that the claims have written description in the specification but that previously raised grounds for unpatentability have been avoided. Louis v. Okada, 59 USPQ2d 1073, 1075 (BPAI 2001).

- [158] Claims 1, 63, and 71 provide that X may be O, S, or NR¹⁰.
- [159] Claims 63 and 71 differ from claim 1 with respect to R¹ by eliminating hydrogen and 1-10 carbon alkyl as a substituent for R¹, although alkyl is retained as an optional substituent bonded to the remaining R¹ substituents.
- [160] The remaining substituents in claims 63 and 71 appear to be the same as those listed in claim 1 except that in some cases choices have been eliminated.

Claims 63 and 71 appear to be subsets of what was claimed in claim 1, consistent with the Johnson holding permitting the deletion of subject matter explicitly disclosed.

¹⁴ Joint motion and stipulated partial judgment.

- [161] Dobrusin has not pointed to any embodiments within the specification itself, however, that support claims of the scope of claims 67 and 75.¹⁵

Adding claims 77-80

- [162] The contingency regarding the unpatentability of claims 54, 55, and 58 has been met (supra).
- [163] The contingency with regard to Dobrusin's proposed count has not been met (supra).

Since only one of the two contingencies for adding Dobrusin claims 77-80 has been met, they will not be added.

In sum Dobrusin preliminary motion 4 is GRANTED in part with respect to the addition of claims 67 and 75, but is otherwise DENIED.

Harris preliminary motion 4: substituting new counts and adding claims

- [164] Harris moves to substitute counts H2 and H3 for count 1, to add new Dobrusin claims to correspond to each of the new counts, and to designate various Harris and Dobrusin claims as corresponding to each of the new counts (Paper 49 at 1-2).
- [165] The proposed counts are (Paper 49 at 1, original emphasis):

Harris count 2

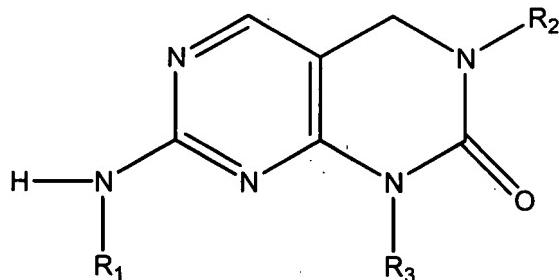
A compound according to Harris claim 1, with the proviso that said compound does not fall within the scope of Harris claim 3.

Harris count 3

A compound according to Harris claim 3.

¹⁵ These claims also have the problem of the erroneous N in T(CH₂)_mC(O)NR⁴NR⁵. Since the issue was not raised earlier, we will leave it to subsequent proceedings to address.

- [166] In practical terms, this translates into counts with the same structural skeleton as the present count,



but with the following differences in the R groups:

	Count 1	Count H2	Count H3
R ¹	hydrogen [-H], alkyl having 1-7 carbon atoms and cycloalkyl having 3-7 carbon atoms	hydrogen, lower alkyl, aryl, aryl-lower alkyl, heteroaryl, heteroaryl-lower alkyl, lower cycloalkyl, or lower cycloalkyl-lower alkyl	aryl
R ²	alkyl having 1-7 carbon atoms and cycloalkyl having 3-7 carbon atoms	lower alkyl, aryl, aryl-lower alkyl, heteroaryl, heteroaryl-lower alkyl, lower cycloalkyl, or lower cycloalkyl-lower alkyl	aryl

R ³	<p>hydrogen [-H], alkyl having 1-7 carbon atoms and cycloalkyl having 3-7 carbon atoms</p>	<p>hydrogen, lower alkyl, aryl, aryl-lower alkyl, heteroaryl, heteroaryl-lower alkyl, lower cycloalkyl, lower cycloalkyl-lower alkyl, lower cycloalkenyl, or lower cycloalkyl-lower alkyl, wherein each said aryl and heteroaryl is independently unsubstituted or substituted by one or more groups selected from the group consisting of halogen, lower alkyl, lower alkoxy, lower- alkoxy lower alkyl, trifluoromethyl, hydroxy, hydroxy lower-alkyl, carboxylic acid, carboxylic ester, nitro, amino, phenyl, --Z--NR⁴R⁵ and --Z--OR⁶; and wherein Z is --O(CH₂)_n-- in which n is 2, 3, or 4, or (CH₂)_m-- in which m is 1, 2, 3, or 4 and wherein each hydrogen of the (CH₂)_m-- chain is present or independently replaced by lower alkyl, hydroxy lower-alkyl, or lower-alkoxy lower-alkyl; and R⁴ and R⁵ are individually hydrogen or lower alkyl or R⁴ and R⁵ together with the nitrogen atom to which they are attached are a 4-, 5-, or 6-membered saturated or partially unsaturated or 5- or 6- membered aromatic heterocyclic group which contains one or more hetero atoms selected from nitrogen, sulfur, and oxygen and which is optionally substituted by lower alkyl, lower alkoxy, and/or oxo and/or which is optionally benz-fused; and R⁶ is hydrogen or lower-alkyl</p>	<p>hydrogen, lower alkyl, aryl, or aryl-lower alkyl</p>
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- [167] Proposed count H2 is considerably broader than count 1.
- [168] Proposed count H3 and count 1 are disjoint.
- [169] Proposed count H3 would be a subset of count H2 but for the proviso for count H2 that explicitly excludes embodiments within the scope of H3.
- [170] According to Harris (2010 at 3), its best proofs require that R² be an aryl substituent, such as phenyl, and possibly that R¹ also be an aryl substituent, such as phenyl.
- [171] As can be seen from the table above, R³ is dramatically broadened with many additional choices and conditions.
- [172] Harris does not provide a reason for broadening the range of choices for R³.
The failure to justify the broadening of R³ is sufficient reason to deny the motion.
See Hillman v. Shyamala, 55 USPQ2d 1220, 1221 (BPAI 2000) (requiring substantive proof as well as formal compliance with the rules).
- [173] According to Harris, counts H2 and H3 are distinct because neither contains subject matter of the other (because the proviso excludes H3 subject matter that would otherwise be within H2) and because H3 embodiments have unexpected results when compared to non-H3, H2 embodiments (Paper 49 at 19).
- [174] The parties agree that the claimed compounds are intended to be used as kinase inhibitors (Paper 49, undisputed fact 14).
- [175] The parties agree that high selectivity is very important for kinase inhibitors (Paper 49, undisputed facts 17-20).

[176] To justify the new

counts, Harris

principally points

(Paper 49 at 12) to

a scatter plot (right,
color omitted) that

maps inhibition of

two kinases, p56^{lck}

versus cdk4.

[177] As an initial matter,

we note that the

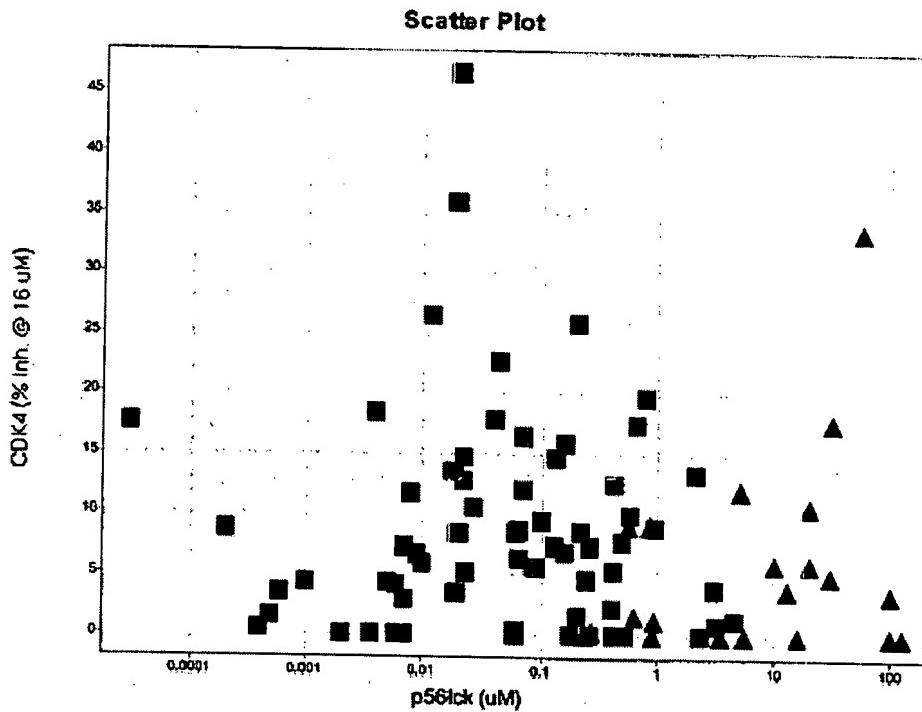
choices for ordinate and abscissa are different and not explained. The ordinate

measures percent inhibition at a set concentration (16 μM), while the abscissa

measures the IC_{50} for p56^{lck} on a logarithmic at concentrations from less than $10^{-4} \mu\text{M}$ to
more than $10^2 \mu\text{M}$.

[178] IC_{50} is the concentration at which 50% of a biochemical process is inhibited [2007
at 2542].

[179] IC_{50} is usually measured in micromoles (μM), although it can be measured in
nanomoles (nM, $10^{-3} \mu\text{M}$) or even picomoles (pM, $10^{-6} \mu\text{M}$) in the case of very potent
inhibitors [2007 at 2542].

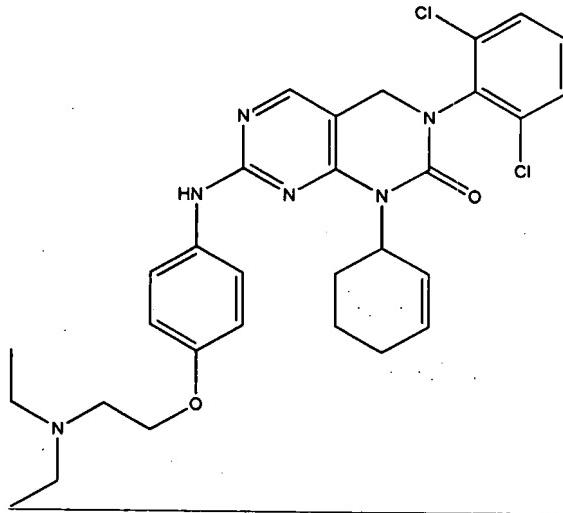


- [180] The scatter plot purports to show the subject matter of count H3 in red squares and subject matter of count H2 in blue triangles with a line of demarcation between the two at about 1 μM on the abscissa.
- [181] It is not clear why different measures of inhibition are used on the ordinate and abscissa, other than to produce this particular distribution, nor is it clear whether this is a standard way of representing data in the art.
- [182] According to Harris, this scatter plot indicates that compositions of count H3 are more potent p56^{lck} inhibitors (i.e., they inhibit at lower concentration) than compositions of count H2.
- [183] According to Harris, inhibition of cdk4 is used to show that the relative selectivity of the compositions for p56^{lck} versus other kinases.
- [184] As an initial matter, the data does not indicate any greater selectivity for H3 compounds versus H2 compounds. In any case, we do not understand Harris to be arguing that selectivity is the basis for the distinction between the two counts' compositions, but rather as evidence of the selectivity for compositions of both counts. Moreover, several of the compounds show considerable inhibition of cdk4 at least at a 16 μM concentration.
- [185] Harris expert, Dr. K.-C. T. Luk testified [2004 at 30]:

While the absolute differences between particular members of the two groups may not be statistically significant, particularly at the interface or line of separation, the data nevertheless demonstrate that there is a structure-activity-relationship. In practical terms, the scatter plot conveys that the R¹/R² aryl compounds are more potent inhibitors of p56^{lck} and thus might be useful in the treatment of such diseases as rheumatoid

arthritis.^[16] At the same time, those compounds do not inhibit cdk4, and would therefore be expected to have minimal cytotoxic side effects that would render their use impossible in the case of chronic administration. The higher potency of the R1/R2 aryl compounds would permit lower dosing, a clinically desirable property.

- [186] We note that any distinction between just two data points is unlikely to be statistically significant, making Dr. Luk's concession a truism but unhelpful.
- [187] There is a significant overlap on the scatter plot between red squares and blue triangles shown on the scatter plot.
- [188] One of the best red squares is Harris Example 42, which according to Dr. Luk has a p56^{lck} IC₅₀ of 0.0002 μM and cdk4 inhibition of 9% at 16 μM [2004 at 25].
- [189] As Dobrusin points out, Example 42 (right) does not fall within the scope of proposed count H3 because it would not meet the definition of R₃, since the R₃ of Example 42 is a cyclohexenyl [2004 at 12] rather than a hydrogen, lower alkyl, aryl, or aryl-lower alkyl as required for the count.
- [190] Cyclohexenyl is a six-carbon cycloalkenyl, which is permitted for R³ in count H2.
- [191] Harris candidly acknowledges the problem in his reply (Paper 81 at 6-7):



¹⁶ Note that a showing of actual reduction to practice would require the inventors to have had an appreciation that the compounds would have worked for their intended purpose. Cooper v. Goldfarb, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998).

The response, respectfully, is that Dobrusin misplaces reliance upon a comparison of selected individual compounds. Harris concedes that it inadvertently misstated that example 42 corresponds to claim 3, and that there is not perfect symmetry between/among example 42 and certain other examples. However, Dr. Luk never stated or suggested that there was no "overlap" in the data. To the contrary, Dr. Luk explicitly addressed the issue of overlap by including the following two-color "scatter plot" in his declaration, HX 2004, ¶ 17: [omitted, see supra]

With specific reference to the above data distribution, Dr.[.] Luk explained, HX 2004, ¶ 17, "the scatter plot exhibits two clearly discernible distributions. The red squares, represent compounds with both R¹ and R² having aryl substituents, are usually active against p56^{lck} with IC₅₀ less than 10 μM. This means these compounds have a good chance of being effective in treating diseases related to p56^{lck}. The blue triangles, representing compounds in the Harris patent that do not have both R¹ and R² being aryl substituents, are usually active against p56^{lck} with IC₅₀ greater than 0.1 μM. This means such compounds will require a significantly higher does to achieve therapeutic efficacy. The line of demarcation between the two groups falls at approximately 1 μM."

- [192] Other red-square examples noted as falling outside count H3 are examples 10, 50, and 76 (Paper 81 at 8) with the following properties from Dr. Luk's declaration [2004]:

Harris Patent Example	p56 ^{lck}	cdk4
10	0.019	3%
50	.006	0%
76	0.53	0%

Of these, examples 10 and 50 place well to the lower right on the scatter plot compared of most of the other red-square data points.

- [193] Once examples 10, 42, 50, and 76 are taken into account, three of the dozen best species would lie outside of count H3, but inside count H2.

- [194] Dr. Luk's testimony does not take this correction into account, consequently his basis for finding a fairly bright line of demarcation between the two subgenera lacks adequate basis.
- [195] The comparison on which Dr. Luk relies, which focuses on aryl groups for R¹ and R², is not commensurate with the differences between the proposed counts because it ignores the significance of R³.

While Harris' candor is appreciated, Dobrusin has a point. When one tries to show patentable distinction between closely related subject matter, the proofs must be commensurate in scope with the distinction being made between the subject matter of the counts. See In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ.2d 1523, 1529 (Fed. Cir. 1998) (making the same point with respect to claim language). Here the proofs are not commensurate because Harris does not account for differences arising out of the R³ limitations. The scope of the proofs for the difference between the two counts is not commensurate with the proposed proofs.

In view of the significance of R³ for distinguishing between the two proposed Harris counts, the failure to explain the broadening of R³ takes on added significance.

Harris has not carried its burden for justifying a change in the count. With no change to the count, the rationale for adding claims is not met. Consequently, Harris preliminary motion 4 is DENIED. Harris preliminary motion 5, which is contingent on the granting of Harris preliminary motion 5, is DISMISSED as moot.

New count

We have the discretion to try to construct a new count in view of the evidence presented to address the needs of the parties despite their failure to justify the specific changes they sought. In the present case, however, the need for high selectivity demonstrated in the record counsels for great caution in any attempt to put together a new count. Consequently, we will not exercise our discretion to do so here.

Reconsideration

To reduce the need to prove contingencies during the priority period, any request for reconsideration should be filed promptly.

ORDER

Upon consideration of the preliminary motions and of the evidence cited and discussed, it is:

ORDERED that Harris preliminary motion 1 for judgment that Dobrusin claims 54-56 and 58-60 are unpatentable be GRANTED;

FURTHER ORDERED that Harris preliminary motion 2 for judgment of unpatentability be DENIED;

FURTHER ORDERED that Harris preliminary motion 3 for judgment that Dobrusin claims 56, 59, and 60 are unpatentable be GRANTED;

FURTHER ORDERED that Harris preliminary motion 4 to substitute two counts be DENIED;

FURTHER ORDERED that Harris preliminary motion 5 for benefit for Harris' proposed counts be DISMISSED as moot;

FURTHER ORDERED that Harris preliminary motion 6 attacking benefit be DISMISSED as outside the scope of the rules;

FURTHER ORDERED that Harris preliminary motion 7 for benefit for Dobrusin's proposed count be DISMISSED as moot;

FURTHER ORDERED that Dobrusin preliminary motion 1 for substitution of a count and other relief be DENIED;

FURTHER ORDERED that Dobrusin preliminary motion 2 seeking additional benefit be DENIED;

FURTHER ORDERED that Dobrusin preliminary motion 3 for benefit for Dobrusin's proposed count be DISMISSED as moot;

FURTHER ORDERED that Dobrusin preliminary motion 4 be GRANTED to the extent that claims 67 and 75 be added, but otherwise be DENIED;

FURTHER ORDERED that any request for reconsideration of this decision be filed within **30 days** of the date of entry for this decision;

FURTHER ORDERED that this interference be remanded to the administrative patent judge designated to handle the interference for further action not inconsistent with this decision; and

FURTHER ORDERED that a copy of this decision be entered in the administrative record of Harris's 6,150,373 patent and of Dobrusin's 09/623,737 patent application.

RICHARD E. SCHAFER
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

MARK NAGUMO
Administrative Patent Judge

BOARD OF
PATENT
APPEALS AND
INTERFERENCES

INTERFERENCE
TRIAL SECTION

cc (electronic mail):

Counsel for Harris (Hoffman-LaRoche Inc.): **Stephen M. Haracz and Kevin C. Hooper** of BRYAN CAVE LLP.

Counsel for Dobrusin (Warner-Lambert Co.): **Rudolf E. Hutz and Ashley I. Pezzner** of CONNOLLY BOVE LODGE & HUTZ.

Notice: Any agreement or understanding between parties to this interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the United States Patent and Trademark Office before termination of the interference as between said parties to the agreement or understanding. 35 U.S.C. 135(c); 37 C.F.R. § 1.661.

Despertt, Sonja

From: Despertt, Sonja on behalf of Interference Trial Section
Sent: Friday, January 30, 2004 7:24 PM
To: 'Ashley I. Pezzner (CONNOLLY BOVE)'; 'Kevin C. Hooper (BRYAN CAVE)'; 'Rudolf E. Hutz (CONNOLLY BOVE)'; 'Stephen M. Haracz (BRYAN CAVE)'
Subject: Interference No. 104798 (RT) Paper No. 99 DECISION on Motions



104798-099.pdf

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 104,798

WILLIAM HARRIS,
CHRISTOPHER HUW HILL, and IAN EDWARD DAVID SMITH
(6,150,373),
Junior Party,

v.

ELLEN MYRA DOBRUSIN,
JAMES MARINO HAMBY, JAMES BERNARD KRAMER,
MEL CONRAD SCHROEDER, HOWARD DANIEL HOLLIS SHOWALTER,
PETER TOOGOOD, and SUSANNE A. TRUMPP-KALLMEYER
(09/623,737),
Senior Party.

NOTICE REDECLARING INTERFERENCE
and RESTRICTION REQUIREMENT
(37 CFR §§ 1.610 and 1.640)

A. Redeclaration of interference

The interference between the captioned parties is redeclared to reflect the results of Paper 99. Details of the application, patent, and count remain unchanged from the last redeclaration (Paper 41). Details about claims designated as corresponding to the count appear under headings C of this NOTICE.

B. Standing order

The Standing order as revised in May 2003 can be found at:

<http://www.uspto.gov/web/offices/dcom/bpai/standing2003May.pdf>

The revised STANDING ORDER applies to this interference. It is substantially unchanged. The most significant change for the purposes of this proceeding is that the numbering has changed to better track the order in which issues arise.

C. Claims of the parties

The claims of the parties are:

Harris: 1-16
Dobrusin: 67 and 75

The claims corresponding to Count 1:

Harris: 1
Dobrusin: 67 and 75¹

The claims not corresponding to Count 1:

Harris: 2-16
Dobrusin: None

D. Restriction requirement

Claims 3-6, 9-16, 26-36, 42, 44-46, 48-53 of Dobrusin's 09/623,737 application do not correspond to the count 1 and hence are directed to a patentably distinct invention. Since Dobrusin's application is subject to a day-for-day term adjustment for time spent in an interference, 35 U.S.C. 154(b)(1)(C)(i), Dobrusin's non-corresponding claims are hereby restricted out of Dobrusin's 09/623,737 application pursuant to 35 U.S.C. 121(1). Effective **60 days** from the date of this notice, Dobrusin will not be

¹ Paper 99 points to a formal defect in both claims: the problem of the erroneous second N in "T(CH₂)_mC(O)NR⁴NR^{5".} Since it appears to be readily cured and does not affect the scope of the count the Board will defer to subsequent prosecution, if any, action on the defect absent some compelling showing that it must be cured now.

Interference No. 104,798
Harris v. Dobrusin

Paper 100
Page 3

entitled to any further term adjustment for any application containing these claims as a consequence of this interference. Any traversal of this requirement shall be filed within **30 days of this notice.**

2 February 2004

RICHARD TORCZON
Administrative Patent Judge

cc (via electronic mail):

Counsel for Harris (Hoffman-La Roche Inc.): **Stephen M. Haracz and Kevin C. Hooper** of BRYAN CAVE LLP.

Counsel for Dobrusin (Warner-Lambert Co.): **Rudolf E. Hutz and Ashley I. Pezzner** of CONNOLLY BOVE LODGE & HUTZ.

Despertt, Sonja

From: Despertt, Sonja on behalf of Interference Trial Section
Sent: Monday, February 02, 2004 7:14 AM
To: 'Ashley I. Pezzner (CONNOLLY BOVE)'; 'Kevin C. Hooper (BRYAN CAVE)'; 'Rudolf E. Hutz (CONNOLLY BOVE)'; 'Stephen M. Haracz (BRYAN CAVE)'
Subject: Interference No. 104798 (RT) Paper No. 100 -REDECLARATION and RESTRICTION REQUIREMENT



104798-100.pdf

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

WILLIAM HARRIS,
CHRISTOPHER HUW HILL, and IAN EDWARD DAVID SMITH
(6,150,373),
Junior Party,

v.

ELLEN MYRA DOBRUSIN,
JAMES MARINO HAMBY, JAMES BERNARD KRAMER,
MEL CONRAD SCHROEDER, HOWARD DANIEL HOLLIS SHOWALTER,
PETER TOOGOOD, and SUSANNE A. TRUMPP-KALLMEYER
(09/623,737),
Senior Party.

Interference No. 104,798

Before SCHAFER, TORCZON, and NAGUMO, Administrative Patent Judges.
TORCZON, Administrative Patent Judge.

DECISION ON REHEARING
(RULE 640)

INTRODUCTION

The Board issued a decision on preliminary motions (Paper 99), which resulted in a redeclaration of the interference and a restriction requirement for Dobrusin (Paper 100) and an order to show cause against Harris (Paper 102).

Dobrusin (Paper 103) has requested reconsideration of the decision granting in part Harris preliminary motions 1 and 3 with respect to Dobrusin claims 56, 59, and 60. Harris opposes the request (Paper 108).

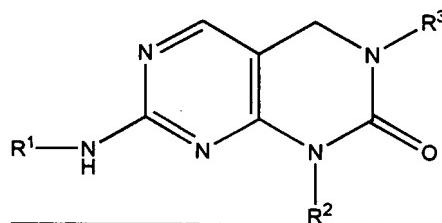
Harris (Paper 105) has requested reconsideration of the decision granting Dobrusin preliminary motion 4 in part and denying Harris preliminary motion 1 in part.

Dobrusin opposes the request (Paper 107). Harris has also responded (Paper 104) to the order to show cause.

DOBRUSIN'S CLAIMS 56, 59, AND 60

Reasons in the decision for holding claims 56, 59, and 60 unpatentable

- [1] Harris preliminary motion 1 (Paper 46) sought a judgment of unpatentability for Dobrusin claims 56, 59, and 60 for lack of written description.
- [2] Claim 56 is a compound with the following general formula (Paper 37 at 7-8):



- [3] Claim 56 depends from claim 55 (Paper 37 at 7).
- [4] Claim 55 depends from independent claim 54 (Paper 37 at 7).
- [5] In claim 56/55/54, R¹ and R², are distinct moieties, independently selected from the same Markush group.
- [6] The support for claims 59 and 60 was not challenged apart from the attack on claim 56.
- [7] The decision (Paper 99) discusses Harris preliminary motion 1 at 14-27.
- [8] The only discussion of claims 56, 59, and 60 in the relevant portion of the decision (Paper 99 at 25-26) rejects the basis Harris provides for finding a lack of written description of these claims:

The R¹ and R² substituents in Dobrusin claims 56, 59, and 60

- [77] Harris argues that there is no basis for selecting six substitutes for R¹ and R² out of the original list of nine.

This argument shows the limits of Harris's combinatorial arguments. Both the retained and the eliminated choices are explicitly listed. The elimination of some, but not all[,] of the choices is the sort of winnowing that Johnson^[1] permits.

- [9] Nevertheless, the decision holds claims 56, 59, and 60 to be unpatentable (Paper 99 at 27).
- [10] In the discussion of Dobrusin preliminary motion 4 to add and amend claims (Paper 99 at 38-48), the Board made the following finding (at 39):
 - [126] A compound of claim 56 meets the trigger of proviso (a) in grandparent claim 54 (because R⁸ and R⁹, which bond to the top two ring carbons, are both hydrogen and the W of WR¹ is -NH-).
- [11] Proviso (a) of claim 54 also requires X, the double-bonded moiety in the lower right of the formula, to be NR¹⁰ (Paper 37 at 6).
- [12] In claim 56, X is oxygen (O), not NR¹⁰.

Consequently, fact finding 126 is incorrect and no other basis is provided in the decision on Harris preliminary motion 1 (or Dobrusin preliminary motion 4) for holding Dobrusin claims 56, 59, and 60 unpatentable.

- [13] Dobrusin argues that the Board erred in holding its claims 56, 59, and 60 to be unpatentable (Paper 103 at 2).
- [14] Harris agrees that the Board erred with regard to fact finding 126, but argues that the error is harmless because of the reasons it advanced in its motions 1 and 3.

Harris preliminary motion 1

- [15] Harris argued (Paper 46 at 23, original emphasis):

¹ In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977).

Just as with the newly created R⁸/R⁹ subgenera, there are no blaze marks in the Dobrusin application that would lead one to selectively choose the particular six R¹/R² groups now recited in claims 56, 59 and 60. Those groups belong to a larger list of nine members, all of which stand on equal footing. There is nothing in the written description that would lead one to select the six particular recited groups, or alternatively, to exclude the three non-recited groups. HX 2004,^[2] ¶¶ 51-54.

Only through random selection and sheer luck could one arrive at precisely the recited group of six, which represents only 1 out of 511 possible combinations. HX 2002, ¶ 19. Under *Ruschig*^[3], that is not enough. Under *Ruschig*, it would not be enough even if there were some reason [to] select six of the original nine, as opposed, say, to three or eight. There are 84 different ways of selecting six out of nine, far too many combinations to constitute a written description of each particular combination.

- [16] Dobrusin admitted Harris preliminary motion 1 facts 42 and 43 (Paper 70 at 43).
- [17] Harris preliminary motion 1 facts 42 and 43 are (Paper 46 at 12-13, original emphasis):

42. The Dobrusin application as filed, including the original claims, describes a list of nine permissible R¹/R² [and R¹⁰] moieties, including the six now recited in claim 56. Se HX 2004, ¶ 52; HX 2001 at page 3, lines 9-11; page 7, lines 7-9; page 106, lines 12-15 (original application claim 1);

43. The differences between the list described in the Dobrusin application as filed and the list now recited in substitute claim 56/55/54 are summarized in the table below:

Definition of R ¹ and R ² from Specification	Definition of R ¹ and R ² from New Claim 56
H	Hydrogen [= H]
(CH ₂) _n Ar	(CH ₂) _n Ar
COR ⁴	ELIMINATED

² Harris exhibits are numbered from 2001; Dobrusin exhibits, from 1001.

³ In re Ruschig, 379 F.2d 990, 154 USPQ 118 (CCPA 1967).

(CH ₂) _n heteroaryl	(CH ₂) _n heteroaryl
(CH ₂) _n heterocyclyl	(CH ₂) _n heterocyclyl
C ₁ -C ₁₀ alkyl	C ₁ -C ₁₀ alkyl
C ₃ -C ₁₀ cycloalkyl	C ₃ -C ₁₀ cycloalkyl
C ₂ -C ₁₀ alkenyl	ELIMINATED
C ₂ -C ₁₀ alkynyl	ELIMINATED

- [18] In its material fact 44, Harris avers (Paper 46 at 13, underlining in original):

The Dobrusin application as filed, including the original claims, does not describe a discrete subgenus of the three R¹/R² moieties that are not recited in claim 56, but which are included in the list of nine repeatedly described in the specification. HX 2004, ¶¶ 53-54; HX 2001, pages 1-131.

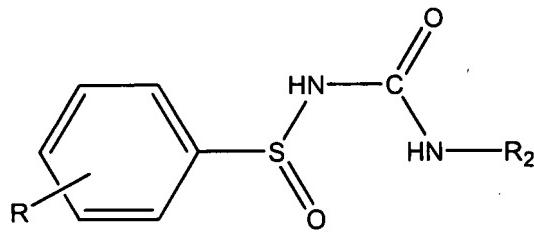
- [19] Dobrusin disagrees (Paper 70 at 3-4):

Dobrusin denies that Harris's fact paragraph no. 44 is correct. Dobrusin has not defined any new discrete subgenus by eliminating some of the disclosed moieties from the fully supported Markush groups set forth in the Dobrusin application and original claims. The list of moieties are alternatively usable for the purposes of the invention and elimination of some of the moieties does not create a new discrete subgenus. Dobrusin disagrees that the list is not otherwise described by the Dobrusin application.

While the parties agree on a core fact--Dobrusin consistently disclosed and claimed a Markush group of nine substituents for R¹ and R² until it sought to amend claim 54, the ultimate parent claim of claim 56--they disagree on the inference about possession of the invention that can be drawn from that fact. The arguments have focused on four cases: Ruschig, Johnson, In re Driscoll, 562 F.2d 1245, 195 USPQ 434 (CCPA 1977), and Fujikawa v. Wattanasin, 93 F.3d 1559, 39 USPQ2d 1895 (Fed. Cir. 1996). All four cases involve claims added or amended to narrow the scope of what

was being claimed from within Markush groups. Ruschig and Fujikawa require clear guidance for narrowing amendments, while Johnson and Driscoll liberally allow narrowing to overcome a rejection. While superficially divergent, the holdings can be reconciled to focus on (1) how many choices are available, (2) how narrow the claim becomes, and (3) how much guidance the specification provides. In considering these cases, we heed the admonition in Driscoll, 562 F.2d at 1249, 195 USPQ at 438 that "the precedential value of cases in this area is extremely limited." Accord University of Rochester v. G.D. Searle & Co., 358 F.3d 916, 928, 69 USPQ2d 1886, 1895-96 (Fed. Cir. 2004) (distinguishing several precedents on their facts).

Ruschig affirmed the rejection of claim 13 to a compound, N-(p-chlorobenzene-sulfonyl)-N'-propylurea, which the appellant admitted was not named or identified in the specification. Ruschig had broadly disclosed a genus of benzenesulfonyl ureas of the formula in original claim 2 of:



where R is a Markush group of two members and R₂ is a Markush group of four.⁴ 379 F.2d at 994, 154 USPQ at 121. Claim 13 requires selection of a single member

⁴ Counting members of a Markush group is complicated because some members are actually ranges (e.g., 1-6 carbon alkyl), contain additional Markush groups, or permit optional substituents, among other kinds of variations. While it is a gross oversimplification, for the purposes of this discussion, the number of Markush group members in each case is based on the members expressly identified without consideration to any further choices inherent in any member of the Markush group.

from each Markush group (R is chloro and R₂ is propyl) with R in a specific position (para to the sulfonyl). The court looked, in the absence of a specific example, for guidance from the specification to make the necessary choices. While some of the guidance came close, ultimately the court deemed it insufficient. In explaining its decision, the court originated the use of blazemarks in a forest as a metaphor in this area of patent law. 379 F.2d at 994-95, 154 USPQ at 122.

In Johnson, the invention involved high molecular weight polyarylene polyethers with a recurring unit designated -O-E-O-E'-. 558 F.2d at 1009, 194 USPQ at 190. After losing an interference, Johnson amended claim 1 to avoid the subject matter of the lost count by adding the provisos, 558 F.2d at 1013, 194 USPQ at 195:

with the provisos that E and E' may not both include a divalent sulfone group and may not both include a divalent carbonyl group linking two aromatic nuclei.

In Johnson's specification, 558 F.2d at 1018, 194 USPQ at 195 (emphasis in original):

Fifty specific choices are mentioned for the E precursor compound, a broad *class* is identified as embracing suitable *choices* for the E' precursor compound, and twenty-six "examples" are disclosed which detail fifteen species of polyarylene polyethers. Only fourteen of those species and twenty-three of the "examples" are within the scope of the claims now on appeal. Two of the many choices for E and E' precursor compounds are deleted from the protection sought, because appellant is *claiming less* than the full scope of his disclosure.

According to the court, the application in question "clearly describes the genus and the two special classes of polymer materials excluded therefrom." 558 F.2d at 1018, 194 USPQ at 196. Moreover, the court noted that the applicants were "narrowing their claims, and the full scope of the limited genus now claimed is supported in appellants'

earlier application, generically and by specific examples." 558 F.2d at 1018, 194 USPQ at 196. The court continued:

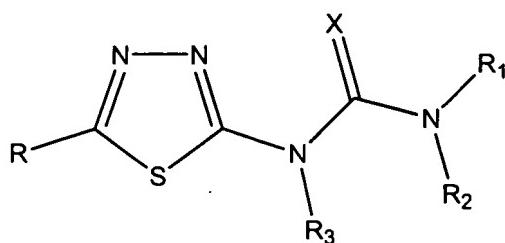
The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.

558 F.2d at 1019, 194 USPQ at 196. While the court agreed that:

[i]nsufficiency under §112 could not be cured by citing the causes for such insufficiency, it is not true that the factual context out of which the question under §112 arises is immaterial. Quite the contrary. Here, as we hold on the facts of this case, the "written description" in the 1963 specification supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the part remaining. The facts of the prosecution are properly presented and relied on, under these circumstances, to indicate that appellants are merely excising the invention of another, to which they are not entitled, and are not creating an "artificial subgenus" or claiming "new matter."

558 F.2d at 1019, 194 USPQ at 196. Johnson did not distinguish Ruschig or discuss blaze marks. The court appeared adamant, however, that a narrowing amendment carving out expressly disclosed species to avoid a rejection is permissible.

In Driscoll, original claim 1 was directed to a genus of compounds with the following general formula:



in which R was selected from a Markush group with fourteen members, R₁ from a group with three members, R₂ from a group with eight members, R₃ from a group with two members, and X from a group with two members; where a proviso further limited the choices for R₁ and R₂. 562 F.2d at 1247, 195 USPQ at 435. Claim 13 was identical to original claim 1 except that R was limited to a single member, C₁-C₆ alkylsulfonyl, of the original fourteen-member Markush group for R. 562 F.2d at 1246, 195 USPQ at 435. The specification stressed the importance of an organic substituent at the 5-position of the thiadiazole moiety (i.e., the R substituent), 562 F.2d at 1249, 195 USPQ at 437.

Driscoll, in discussing Markush practice, explained that:

It is generally understood that in thus describing a class of compounds an applicant is, in effect, asserting that the members of the Markush group do not fall within any recognized generic class, but are alternatively usable for the purposes of the invention, and therefore, regardless of which of the alternatives is substituted on the basic structure, the compound as a whole will exhibit the disclosed utility.

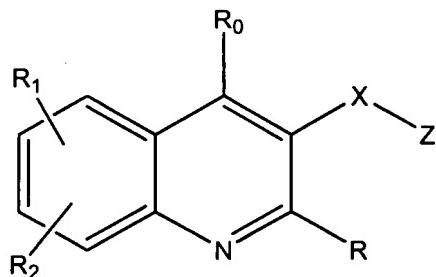
562 F.2d at 1249, 195 USPQ at 437. The court expressly distinguished Ruschig:

Any seeming similarity between Ruschig and the present case is illusory, however, because the structural formula there relied on could have described, at best, only a subgenus including the specific compound claimed, and not the compound itself. In this respect, Ruschig is readily distinguishable from the present case where the exact subgenus claimed is clearly discernible in the generalized formula of the thiadiazole urea set forth in the earlier filed application.

562 F.2d at 1249, 195 USPQ at 438.

In Fujikawa, Fujikawa moved to have Wattanasin add a claim in an interference.

Wattanasin disclosed a compound with the following general formula:



in which R and R₀ are independently selected from a Markush group with four members (including C₃₋₇ cycloalkyl and fluorophenyl) and R¹ and R² are independently selected from a nine-member Markush group. Fujikawa proposed a subgenus in which R was cyclopropyl and R₀ was 4-fluorophenyl. The other choices were not in dispute. 93 F.3d at 1570, 39 USPQ2d at 1904. The court rejected Fujikawa's attempt to find express disclosure in the Markush lists themselves. Citing Ruschig, the court rejected Fujikawa's "laundry list" approach to picking and choosing among the alternatives in different Markush groups absent some guidance or blazemarks. As in Ruschig, the court found that various expressed preferences in the disclosure came close to teaching the subgenus, but not close enough. 93 F.3d at 1571, 39 USPQ2d at 1905.

Johnson and Driscoll suggest, but do not expressly hold, that the fact that the claims in question had been narrowed to avoid rejections was a relevant consideration. The test for written description, however, uses an objective standard--what one skilled in the art would have understood--rather than the inventor's subjective intent to determine whether a claim has adequate support. E.g., Fujikawa, 93 F.3d at 1570, 39 USPQ2d at 1904. Note that in Fujikawa, Wattanasin contended that it had not invented the subgenus that Fujikawa was moving to have Wattanasin claim. If inventor

intent were part of the test for written description, then the court in Fujikawa should have factored in Wattanasin's resistance, but it did not. Instead, the cases can be reconciled without any resort to inventor intent by looking to the relationship between the initial and final Markush groups.

When the selection is made within a single, relatively small Markush group, as in Driscoll, the Markush group may be adequate disclosure by itself of any choice within the Markush group, but when the selection involves more than a single Markush group (Ruschig, Johnson, and Fujikawa), the combination of choices between the Markush groups makes the complexity of the selection grow at a rate much faster than simply the number of members in each Markush group. For large numbers of choices, sufficient examples within the scope of the narrowed claim or greater guidance in the specification may provide the "something more" that Ruschig requires. 379 F.2d at 994, 154 USPQ at 122. In the case of a subgenus, even an example of a single species might not suffice to show possession. In re Smith, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) (finding no "anomaly" in the fact that a broader claim might have support where a narrower claim would not).

- [20] Although only a single Markush group is narrowed in the present case, that Markush group independently defines two moieties--in essence they are two Markush groups that have been defined together for convenience.
- [21] Where there had been 81 subgenera (nine independent choices at two moieties), there are now 36 (six independent choices at two moieties).

A narrowing of the choices for either R¹ or R² independently might have been permissible under the reasoning of Driscoll because one skilled in the art would have understood each to member of the Markush group to be an alternative for the moiety being more narrowly defined. The facts here, however, are closer to Ruschig, Johnson, and Fujikawa because the selection involves Markush selections for more than one moiety with a corresponding increase in the complexity of the choice.

- [22] It is not apparent from Dobrusin's arguments, why both these moieties should be changed in tandem, particularly since they are independently selected.
- [23] Dobrusin has not pointed us to examples within the scope of the new claim that would help to show that the new subgenus was contemplated all along.
- [24] Claim 56 is unpatentable for lack of adequate written description under § 112(1) of the new Markush group of substituents for R¹ and R².

The present case is distinguishable from Johnson because Dobrusin not pointed to comparable guidance in its specification for discerning the subgenera that Dobrusin is now claiming. The original decision was wrong when it broadly held that Johnson permitted a narrowing amendment involving both R¹ and R² without guidance.

Harris preliminary motion 3

- [25] Harris also contended that claims 56, 59, and 60 were unpatentable under paragraphs 1, 2, and 4 of § 112 (Paper 48 at 1).
- [26] Dobrusin responded that its proposed amendment to claim 56 would overcome the problem (Paper 72 at 2; Paper 103 at 5).
- [27] The Board granted Harris preliminary motion 3 (Paper 99 at 31).

- [28] Harris contends that any error in granting Harris preliminary motion 1 with respect to unamended claims 56, 59, and 60 was harmless because these claims were held to be unpatentable in view of Harris preliminary motion 3 (Paper 108 at 4).

We agree with Harris that, with respect to Harris preliminary motion 1, any error with regard to unamended claims 56, 59, and 60 was harmless.

Amended claim 56

- [29] Harris argues (Paper 108 at 4) that we should end our reconsideration based on Dobrusin's request without reaching the amended claim because the Dobrusin motion amending the claim was not part of Dobrusin's request for reconsideration.

The controlling rule, 37 C.F.R. § 1.640(c), requires in part:

"The request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision."

- [30] Dobrusin's request says (Paper 103 at 5, original emphasis):

The Board erred in paragraph no. 126 in stating

"A compound of claim 56 meets the trigger of proviso (a) in grandparent claim 54 (because that^[5] proviso (a) is R⁸ and R⁹, which bond to the top two ring carbons, are both hydrogen, and the W is -NH-)."

However, proviso (a) is not triggered because proviso (a) also requires that X is NR¹⁰. In claim 56, X is O. This was acknowledged by Harris by not including claim 56 and dependent claims 59 and 60 in its proviso rejection.

- [31] Fact finding 126 appears in the portion of the decision (Paper 99 at 38-48) addressing Dobrusin preliminary motion 4.

⁵ The word "that" is not in the original decision (Paper 99 at 39).

Dobrusin's request for reconsideration is not a model of clarity. Harris is correct that the request does not expressly seek review of the decision on Dobrusin preliminary motion 4. On the other hand, Dobrusin repeatedly emphasizes amended claim 56 and clearly identifies fact finding 126 as erroneous.

The interference rules are designed for the orderly administration of interferences. In determining whether Dobrusin complied with § 1.640(c) by specifying "with particularity the points believed to have been misapprehended or overlooked", we balance at least the following considerations: (1) did Harris have notice of the issue and (2) is Dobrusin impermissibly enlisting the Board to make its case in the first instance. On the facts of this request, Harris cannot reasonably argue that it did not know Dobrusin was challenging the denial of the amendment to claim 56. Moreover, Dobrusin clearly identifies the salient error in the decision: in amended claim 56, X is O rather than NR¹⁰ as required in proviso (a). Consequently, the Board need not scour the record to make out Dobrusin's case for it. While Dobrusin could have better complied with the requirement to "specify with particularity the points believed to have been misapprehended or overlooked", § 1.640(c), a rigid application of the rule in the present case is neither necessary nor appropriate. Cf. 37 C.F.R. § 1.601 ("This subpart shall be construed to secure the just, speedy, and inexpensive determination of every interference."). We hold that Dobrusin fairly raised the issue of whether the motion to amend claim 56 was properly denied.

- [32] Harris also argues that Dobrusin was at fault in its initial motion for having failed to explain how amended claim 56 avoided the patentability problems raised in the Harris motions.

Under 37 C.F.R. § 1.637(c)(2):

- (2) A preliminary motion seeking to amend an application claim corresponding to a count or adding a claim to be designated to correspond to a count shall:
- (i) Propose an amended or added claim.
 - (ii) Show that the claim proposed to be amended or added defines the same patentable invention as the count.
 - (iii) Show the patentability to the applicant of each claim proposed to be amended or added and apply the terms of the claim proposed to be amended or added to the disclosure of the application; when necessary a moving party applicant shall file with the motion a proposed amendment to the application amending the claim corresponding to the count or adding the proposed additional claim to the application.

- [33] Dobrusin's only explanation regarding the patentability of claim 56 is (Paper 59 at 4):

Dobrusin proposes to amend claim 56 to overcome the 35 U.S.C. §112 allegations raised by Harris.

- [34] Harris notes (Paper 108 at 5) that the decision scolded Dobrusin for not having complied with § 1.637(c)(2) with respect to proposed claims 61-76.
- [35] The Board denied entry of amended claim 56 on the basis of an argument that Harris made regarding claim 54 rather than claim 56.

Dobrusin undoubtably contributed to the problem when it failed to discuss any specific ground of unpatentability under § 112 for amended claim 56 in its preliminary motion 4. Such a discussion would have framed the issues for consideration better and would likely have prevented the Board from misapplying an argument appropriate

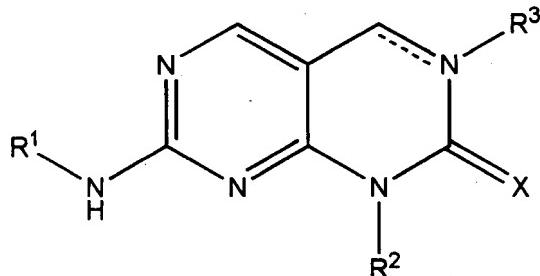
against claim 54 to amended claim 56. Dobrusin could not, however, reasonably have anticipated that the Board would have misapplied the argument. It follows that Dobrusin could not reasonably have been expected to address the misapplied argument. The request for reconsideration was Dobrusin's first opportunity to address the error, which the Board effectively created *sua sponte*. Once the error is pointed out, the fact that it is an error is readily ascertainable from the face of the record. It is hard to see how Harris is prejudiced by the reconsideration of an argument that Harris never made and that is wrong on its face. In any case, the question is moot for the reasons provided below.

- [36] In opposition to Dobrusin's preliminary motion 4 to amend claim 56, Harris argued that Dobrusin had failed to address patentability problems already raised for claim 56, including "subgenera that have been created out of thin air" (Paper 67 at 14-15).
- [37] Amended claim 56 appears to retain the problem raised in Harris preliminary motion 1 regarding unamended claim 56's lack of support for the narrowing of R¹ and R².
- [38] Dobrusin's response was to point to its claim charts, but those do not provide either sufficient examples or the necessary guidance for what is now claimed for the reasons given above.

DOBRUSIN'S ADDED CLAIMS 67/63 AND 75/71

- [39] Dobrusin moved, in its preliminary motion 4 (Paper 59 at 1), to add claims 67 and 75 among others.
- [40] The Board found (Paper 99 at 46, footnotes omitted):

- [150] Remaining proposed claims 67 and 75 have the following basic structure:



- [151] In each case, Dobrusin cites as support for claims 67 and 75 "original claim 2 and claim 55" (Paper 59, App. 2 at 33 and 54).
- [152] Dobrusin offers no other argument for the support of claims 67 and 75 specifically beyond that provided in Appendix 2.
- [153] Claim 55 is not said to be an original claim and does not appear to be original in the PCT application [1007].

We note that the mere fact that a claim is an original claim is no guarantee of written description. Enzo Biochem, Inc. v. Gen-Probe, Inc., 296 F.3d 1316, 1329, 63 USPQ2d 1609, 1616 (Fed. Cir. 2002). The Enzo Biochem decision was concerned with a case in which neither the original claim nor the specification provided an adequate description of a claimed structure or material, for instance, where the description was of a function without a clear showing of necessarily corresponding structure. In the present case, the claims describe chemical genera with structural rather than functional limitations, so the concern of Enzo Biochem does not appear to apply to these facts.

- [154] Claim 2 appears to be an original claim in the PCT application [1007 at 108].
- [155] Claim 2 depends from claim 1, but specifies N, H, and NH at positions that yield the same basic structure as claims 67 and 75, as shown above.
- [156] Claims 67 and 75 depend from claims 63 and 71, respectively, in the same relationship as claim 2 depends from claim 1 except that claim 2 specifies the substitution of two nitrogens that are already present in claims 63 and 71.

- [157] Dobrusin has already conceded the unpatentability of claims 1 and 2 in view of prior art (Paper 37 at 4).

The burden to "show patentability" includes not only a requirement to show that the claims have written description in the specification but that previously raised grounds for unpatentability have been avoided. Louis v. Okada, 59 USPQ2d 1073, 1075 (BPAI 2001).

- [158] Claims 1, 63, and 71 provide that X may be O, S, or NR¹⁰.

- [159] Claims 63 and 71 differ from claim 1 with respect to R¹ by eliminating hydrogen and 1-10 carbon alkyl as a substituent for R¹, although alkyl is retained as an optional substituent bonded to the remaining R¹ substituents.

- [160] The remaining substituents in claims 63 and 71 appear to be the same as those listed in claim 1 except that in some cases choices have been eliminated.

Claims 63 and 71 appear to be subsets of what was claimed in claim 1, consistent with the Johnson holding permitting the deletion of subject matter explicitly disclosed.

- [161] Dobrusin has not pointed to any embodiments within the specification itself, however, that support claims of the scope of claims 67 and 75.

- [41] Harris argues that the analogy to Johnson is not apt because (Paper 105 at 5-6, original emphasis):

...Johnson would require a "blazemark" in Dobrusin's application to the specific R¹ subgenus recited in claims 67 and 75. This point was addressed in Harris Opposition 4 (Paper No. 67) at page 23, and in HX 2004, ¶52.

In Johnson, the applicant used a proviso to exclude from a genus two particular compounds that were lost in an earlier interference. In finding adequate written description of the newly claimed subgenus, 558 F.2d at 1018, 194 USPQ at 196, the court emphasized that the applicant's specification (1) described the full genus (without the proviso) and (2) also specifically described, in an example, the compounds sought to be excluded by the proviso[.]

- [42] Citing Fujikawa, Harris argues (Paper 105 at 8, original emphasis):

Neither Dobrusin nor the Board has identified a blazemark in the Dobrusin specification that leads to the particular seven-member subgenus of R¹ moieties recited in Dobrusin's new claims 67 and 75. To the contrary, the Board expressly acknowledged that Dobrusin had "not pointed to any embodiments within the specification itself...that support claims of the scope of claims 67 and 75." Paper 99 at 48 [Fact 161]. It is submitted that that explicit finding should have been the end of the matter as to whether Dobrusin carried its burden; *Johnson* cannot serve to write into Dobrusin's application something that is plainly not there.

- [43] Dobrusin counters, citing Driscoll, that a Markush group is an adequate disclosure of a subset of the same Markush group.

Claims 67 and 75 differ from those in Driscoll because choices are eliminated from more than one Markush group in original claims 1 and 2. At the same time, the lack of any specific example within the scope of the claims is sufficient to distinguish Johnson. While claims 67 and 75 are not as narrow as a single compound, as was the case in Ruschig, Fujikawa shows that even for a subgenus the lack of an example means that some other guidance or blazemark is required.

- [44] Dobrusin did not point us to a blazemark in its motion 4 for making the selections involving more than one Markush group.

- [45] Neither claim 67 nor claim 75 has adequate written support within the meaning of 35 U.S.C. 112(1).

HARRIS'S RESPONSE TO THE ORDER TO SHOW CAUSE

- [46] Harris was placed under an order to show cause (Paper 102) why judgment should not be entered against Harris for failure, as junior party, to file a preliminary statement. 37 C.F.R. § 1.640(d).

- [47] Harris responded that if, after consideration of the requests for reconsideration, Dobrusin had no interfering claims, then judgment on priority against Harris would not be appropriate (Paper 104 at 1).

A lack of patentable claims can be a basis in itself for declining to reach priority.

Brenner v. Manson, 383 U.S. 519, 528 n.12 (1966):

[T]here is no basis for the proposition that even where an applicant for an interference presents a claim which on its face is unpatentable, a complicated and frequently lengthy factual inquiry into priority of invention must inexorably take place.

Moreover, provoking an interference by adding claims that lack support is precisely the sort of thin pretext targeted for enhanced scrutiny in Gluckman v. Lewis, 59 USPQ2d 1542, 1543-44 (BPAI 2001) (nonprecedential), cited with approval in Berman v. Housey, 291 F.3d 1345, 1354, 63 USPQ2d 1023, 1029-30 (Fed. Cir. 2002). We do not consider the issue to be one of no interference-in-fact, if only because stretching no interference-in-fact to cover this circumstance will lead to confusion, but like no interference-in-fact it is a reason to terminate an interference without reaching priority.

Accord "Rules of Practice Before the Board of Patent Appeals and Interferences", 68 Fed. Reg. 66648, 66666, 66689 (proposed 26 Nov. 2003) (to be codified at 37 C.F.R. pt. 41). As the proposed rule notes, however, "[a]n attack on standing must necessarily be effective with respect to all of an opponent's claims on which the determination of interference-in-fact depends".

- [48] All of Dobrusin's involved claims have now been found to lack written description, either in the original decision or as a consequence of this decision on reconsideration.

Consequently, Dobrusin lacks standing to prosecute this interference.

CONCLUSION

We have reviewed the requests for reconsideration, the oppositions to these requests, and Harris's response to the order to show cause. As a consequence of our review, we find that Dobrusin's amended claim 56, its dependent claims 59 and 60, and added claims 67 and 71 lack adequate written description. Since Dobrusin has no involved claim with adequate written description, Harris has demonstrated why judgment should not be entered against Harris. This interference is now ripe for judgment. A copy of this decision will be entered in the administrative record of Harris's 6,150,373 patent and of Dobrusin's 09/623,737 patent application.

RICHARD E. SCHAFER
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

MARK NAGUMO
Administrative Patent Judge

BOARD OF
PATENT
APPEALS AND
INTERFERENCES

INTERFERENCE
TRIAL SECTION

cc (electronic mail):

Counsel for Harris (Hoffman-La Roche Inc.): **Stephen M. Haracz** and **Kevin C. Hooper** of BRYAN CAVE LLP.

Counsel for Dobrusin (Warner-Lambert Co.): **Rudolf E. Hutz** and **Ashley I. Pezzner** of CONNOLLY BOVE LODGE & HUTZ.

Notice: Any agreement or understanding between parties to this interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the United States Patent and Trademark Office before termination of the interference as between said parties to the agreement or understanding. 35 U.S.C. 135(c); 37 C.F.R. § 1.661.

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

WILLIAM HARRIS,
CHRISTOPHER HUW HILL, and IAN EDWARD DAVID SMITH
(6,150,373),
Junior Party,

v.

ELLEN MYRA DOBRUSIN,
JAMES MARINO HAMBY, JAMES BERNARD KRAMER,
MEL CONRAD SCHROEDER, HOWARD DANIEL HOLLIS SHOWALTER,
PETER TOOGOOD, and SUSANNE A. TRUMPP-KALLMEYER
(09/623,737),
Senior Party.

Interference No. 104,798

Before SCHAFER, TORCZON, and NAGUMO, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

JUDGMENT - RULE 640

Dobrusin, the provoking party, lacks a claim with sufficient written description as required under 35 U.S.C. 112(1) (see Paper 109).

Consequently, it is:

ORDERED that judgment on priority as to Count 1 is awarded against Dobrusin;

FURTHER ORDERED that Dobrusin is not entitled to a patent containing claims

54-56 & 58-80 of Dobrusin's 09/623,737 patent application;

FURTHER ORDERED that the Dobrusin preliminary statement be returned unopened; and

FURTHER ORDERED that a copy of this decision be entered in the administrative record of Harris's 6,150,373 patent and of Dobrusin's 09/623,737 patent application.

RICHARD E. SCHAFER
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

MARK NAGUMO
Administrative Patent Judge

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Paper [redacted]

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 104,798

WILLIAM HARRIS,
CHRISTOPHER HUW HILL, and IAN EDWARD DAVID SMITH
(6,150,373),
Junior Party,

v.

ELLEN MYRA DOBRUSIN,
JAMES MARINO HAMBY, JAMES BERNARD KRAMER,
MEL CONRAD SCHROEDER, HOWARD DANIEL HOLLIS SHOWALTER,
PETER TOOGOOD, and SUSANNE A. TRUMPP-KALLMEYER
(09/623,737),
Senior Party.

REDECLARATION
(37 CFR § 1.640)

The captioned interference is redeclared to address errors in claim correspondence in Papers 41 and 100. The claim correspondence for Dobrusin omitted claims that had been held or stipulated to be unpatentable. The corrected claim correspondence is as follows:

The claims of the parties are:

Harris: 1-16
Dobrusin: 1-16, 26-36, 42-53, 54-56, 58-60, 67 and 75

The claims corresponding to Count 1:

Harris: 1
Dobrusin: 1, 2, 7, 8, 43, 47, 54-56, 58-60, 67 and 75

The claims not corresponding to Count 1:

Harris: 2-16
Dobrusin: None

The claim correspondence in this redeclaration differs from the claim correspondence listed in the judgment (Paper 110) as well. Since there is a request for reconsideration of that judgment pending (Paper 112), any change to the judgment will be addressed in the context of the reconsideration.

RICHARD TORCZON
Administrative Patent Judge

cc (via electronic mail):

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(09/623,737),
Senior Party.

Interference No. 104,798

Before SCHAFER, TORCZON, and NAGUMO, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

DECISION ON REHEARING

INTRODUCTION

The Board issued a decision on reconsideration (Paper 109) that resulted in a judgment (Paper 110) against Dobrusin for lack of a claim with written description under 35 U.S.C. 112(1). The decision on reconsideration was a significant modification of the original decision (Paper 99), which had left Harris under an order to show cause (Paper 102). Consequently, the decision on reconsideration (Paper 109) was a new decision. Cf. 37 C.F.R. § 1.658(b). Dobrusin now requests (Paper 112) reconsideration of Paper 109. Harris opposes (Paper 115).

DISCUSSION

According to Dobrusin, the decision misapprehended a critical fact when it denied Dobrusin preliminary motion 4 seeking amendment of Dobrusin claim 56. Entry of claim 56 would mean that Dobrusin would have a claim remaining in the interference and that Harris's response to the order to show cause was not sufficient.

Dobrusin notes that the basis for holding unpatentability--that a further limitation in dependent claim 56 lacked support--is not supported by the record for the amended version of claim 56, which shows the unsupported limitation in brackets, indicating that the limitation was removed. Without the further limitation, the Markush choices for R¹ and R² in amended claim 56 find commensurate support in original claim 1. Claims 59 and 60 stood or fell with claim 56.

Harris argues that any problem in the decision arose from Dobrusin's original failure in preliminary motion 4 to show clearly why it was entitled to entry of its amended and added claims. Instead, Harris argues that Dobrusin improperly recruited the Board to make out Dobrusin's case for it, citing Keebler Co. v. Murray Bakery Prods., 866 F.2d 1386, 1388, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989); Hillman v. Shyamala, 55 USPQ2d 1220, 1222 (BPAI 2000) (Trial Section precedent); LeVeen v. Edwards, 2002 WL 746168, *3 (BPAI) (nonprecedential); see also Stevens v. Tamai, App. No. 03-1479, slip op. at 16-17 (Fed. Cir. 4 May 2004) (reversing for failure to comply with Rule 637(f) and for reliance on Board and opposing party to plumb the administrative record).

The Keebler Co. decision involves an argument on appeal that the Trademark Trial and Appeal Board (TTAB) erred in denying motions when the basis for the error

was not presented in the supporting affidavits filed with the TTAB. The present facts are distinguishable since Dobrusin's appendices provided the relevant facts. The problem lay in the adequacy of Dobrusin's supporting argument. Similarly, Hillman involved a complete absence of proof or argument supplying a fact or justification necessary for relief. We do not understand Harris to be arguing that Dobrusin provided absolutely no basis for relief in its preliminary motion 4.

LeVeen is closer to the mark. In LeVeen, the Board characterized the movant's argument as "[o]ff the cuff and aimless rambling about a variety of subjects" and expressed frustration that "[t]here is no glue that binds or thread that ties the arguments into a meaningful presentation." 2002 WL 746168, *3. The Board, however, treated the problem as one of discretion: "The [administrative patent judge] could not have abused his discretion in connection with arguments or facts which were not presented and developed by [the movant]." Thus, the question presented is whether we abused our discretion in divining a thread of Dobrusin's justification from Dobrusin's appendices when the argument itself was deficient.

The amount of additional analysis required, including two decisions on reconsideration with attendant briefing, suggests that exercising discretion to address the merits in the first instance may have been ill-advised. Moreover, we agree with Harris (Paper 115 at 5) that the development of Dobrusin's argument on amended claim 56, particularly in Dobrusin preliminary motion 4, was deficient. We did, however, address the merits and now that the facts have been developed, there does not seem to be any argument on the merits that the two aspects of claim 56 that had been held to

be unsupported are in fact supported. Consequently, having already elucidated the necessary facts, the only remaining question is whether the Board's acting on these facts prejudices Harris unduly. The fact that Harris may lose is not, in itself, an undue prejudice.

In our last reconsideration, we noted that Dobrusin's motion could have been more helpful, but that Harris had not shown prejudice sufficient for us to ignore a clear error in our decision that arose *sua sponte* (Paper 109 at 16). Harris has not shown much in the way of prejudice with respect to this second error either. When, as here, the error is clear we can reasonably exercise discretion to address and cure the error.

DECISION

Upon consideration of Dobrusin's request for rehearing (Paper 112) and Harris's opposition (Paper 115), it is:

DECIDED that the request for rehearing be GRANTED;

FURTHER DECIDED that Dobrusin preliminary motion 4 be GRANTED with respect to amended claims 56, 59 and 60;

FURTHER DECIDED that the judgment in Paper 110 be WITHDRAWN, except that Dobrusin's preliminary statement has been and remains returned unopened; and

FURTHER DECIDED that a copy of this decision be entered in the administrative record of Harris's 6,150,373 patent and of Dobrusin's 09/623,737 patent application.

RICHARD E. SCHAFER
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

MARK NAGUMO
Administrative Patent Judge

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